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NO.

IN THE

Supreme Court of the United States

OCTOBER TERM 1974

RICHARD J. DUFFY,
Petitioner,

v.

GERALD BARNES, et al.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Petitioner, Richard J. Duffy, respectfully prays that a Writ of Certiorari be granted to review the amended judgment on rehearing and the amended opinion of the United States Court of Appeals for the Third Circuit entered in this proceeding on January 27, 1975, following a rehearing *en banc* ordered by the Court *sua sponte*.

The respondents to this Petition are Gerald Barnes, Joseph R. Preziosi, William F. McGuinness, James B. Duke, Richard A. Craig, Charles C. Faroni, Richard Baubles and Donald Sager.

Vincent J. Frilette and Paul R. Weisz, parties to an unrelated appeal that was argued and decided together with the present cause, are also respondents here by reason of being parties below in a position ~~adverse to~~ LIKE that of petitioner.

Charles N. Kimberlin, Jr., and Elroy M. Gladrow are the other parties to the unrelated appeal and stand in ~~a like~~ AN ADVERSE position as that of petitioner. None of the parties to the unrelated appeal have joined in this petition.

CITATIONS TO OPINIONS BELOW

The unreported opinions of the District Court for the District of New Jersey are printed at A-1 and A-10.[1]

The opinion of the Court of Appeals *en banc*, Judges Van Dusen and Adams dissenting, entered in the consolidated appeals taken from the above-cited district court decisions, and entered in an unrelated appeal taken from the decision of the District Court for the District of Delaware which was argued and decided together with the present cause, is reported at 508 F.2d 205 and is printed at A-15.

The Order of the Third Circuit substantively amending its opinion and judgment on rehearing is reported at F.2d and is printed at A-55. The amended judgment on rehearing is printed at A-58.

JURISDICTION

The judgment on rehearing of the United States Court of Appeals for the Third Circuit was entered on December 16, 1974, and the amended judgment on rehearing here sought to be reviewed was entered on January 27, 1975. The present petition for certiorari was filed within 90 days of the original judgment on rehearing.

Rehearing *en banc* was ordered *sua sponte* by the Third Circuit on May 6, 1974, subsequent to oral argument, but prior to any decision having been rendered on the merits of the consolidated appeals.

This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

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[1] "A" refers to the Appendix bound with this Petition.

QUESTIONS PRESENTED

(1) Whether a construction of 35 U.S.C. § 24 which conflicts with "every court of appeals that has considered the question"[2] and which "will foreclose a party from obtaining discovery regarding the existence of fraud in the filing of a patent application"[3] intolerably conflicts with the "plain meaning of 35 U.S.C. § 24"[4], the legislative history and congressional intent of Congress respecting such statute, and the paramount public interest "in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct"[5]?

(2) Whether an intermediate federal appellate court may abandon jurisdiction under an Act of Congress [35 U.S.C. § 24] which jurisdiction the court exercised for seven years, and which jurisdiction the Courts of Appeal for the Second, Fifth, Seventh and Tenth Circuits, as well as district courts in the First, Sixth and District of Columbia Circuits have held to be conferred by the statute?

(3) Whether, in due respect of the venerable doctrine of *stare decisis* and the Constitutional doctrine of the separation of legislative and judicial powers, "an intermediate federal appellate court that has for approximately seven years adhered to one interpretation of the congressional intent embodied in section 24 [35 U.S.C. § 24] may properly adopt a new interpretation of that statute because of the actions of an administrative agency and the Court's present views regarding the optimal allocation of jurisdiction in the federal system"[6]?

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[2] Quoted from the dissent of Judge Adams in the case below, concurred in by Judge VanDusen, printed at A-50.

[3] Id. at A-49.

[4] Quoted from dissent of Judge VanDusen in the case below, concurred in by Judge Adams, printed at A-28.

[5] Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 816 (1945).

[6] Dissent of Judge Adams at A-39-40.

(4) Whether this Court should interpret 35 U.S.C. § 24 in view of the diametric conflict between the decision below and "every Court of Appeals that has addressed the subject"[7] and in view of the fact that "this lack of homogeneity among the courts of appeal may result in serious injustice where disclosure of one party's evidence is controlled by the law of this [Third] Circuit, while divulgence of that of the adversary party is governed by the decisions of another Circuit"[8]?

STATUTORY PROVISIONS INVOLVED

§ 24 *Subpoenas, witnesses*

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at

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[7] Id. at A-47.
[8] Id. at A-50.

the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena. 35 U.S.C. § 24 (1952) —emphasis supplied.

STATEMENT OF THE CASE

Petitioner, Richard J. Duffy, is the named inventor of United States Patent No. 3,579,684, assigned to USM Corporation. Respondents, Barnes and Preziosi, are the named inventors of United States Patent Application Serial No. 30,817, assigned to Amerace Corporation. The further respondents in the related cause below are present or former employees of Amerace Corporation having knowledge relevant to the propriety of the named inventorship of the Barnes et al. patent application.

The United States Patent Office on May 10, 1972, declared Interference No. 97,945 to determine first inventorship of certain assertedly common subject matter between the above patent and patent application. On July 11, 1972, Barnes and Preziosi filed a motion and supporting affidavits in the Patent Office Interference proceeding to "correct" inventorship of their application by deleting Barnes as a named coinventor. They concurrently filed a sworn "preliminary statement" by Preziosi alone alleging an invention date that preceded even the hiring of Barnes by Amerace Corporation.

As a condition to correction of inventorship, 35 U.S.C. § 116 requires a sworn showing that the asserted erroneous joinder of inventors occurred "through error, and such error arose without any deceptive intention". Duffy opposed the motion on the grounds that the *ex parte* affidavit showing not only failed to comply with the statutory conditions, but that, when compared with other facts of record, suggested the presence of a "deceptive intention".

The Barnes motion to "correct" inventorship was denied by the Patent Office Examiner on May 17, 1973. Barnes initiated an administrative appeal that was opposed by Duffy on the merits.

Duffy also filed an action in the New Jersey District Court invoking the Court's jurisdiction under 35 U.S.C. §24 for purposes of obtaining discovery of respondents in respect of the inventorship issue, and particularly discovery in respect of the veracity of the *ex parte* showing submitted by the respondents Barnes and Preziosi in support of their motion to correct inventorship.

Although the respondents moved before the district court to quash the requested discovery, the jurisdictional power of the court to order discovery was not disputed having been resolved years earlier by the Third Circuit in *In re Natta*, 388 F.2d 215 (3rd Cir. 1968)[9] (A-7). The district court in a letter opinion denying the Barnes' motion to quash (A-1) succinctly stated the purposes sought to be served by the discovery:

> "Based upon the palpable discrepancies in the junior party's [Barnes et al.] application and preliminary statement, and believing the former to be the product of willful falsehood, Duffy moves for discovery in the hope of successfully advancing a motion pursuant to Rule 56, Patent Office Rules of Practice, to strike the application of the junior party as fraudulently filed." (A-5-6)

Barnes immediately filed an appeal to the Third Circuit Court of Appeals, but both the district court and the Third Circuit declined to stay discovery during the pendency of

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[9] "This statute [35 U.S.C. § 24] manifests a clear congressional intent to make available to parties to patent interferences the broad discovery of the Federal Rules of Civil Procedure." In re Natta, 388 F.2d at 217.

the appeal.[10] Barnes et al. continued to resist discovery resulting in issuance of a second order by the district court (A-10) that was again appealed by Barnes et al.

Following oral argument in the consolidated Barnes et al. appeals but prior to rendition of any opinion, the Third Circuit notified the parties that the Court had *sua sponte* ordered a rehearing *en banc* (A-14). The consolidated Barnes et al. appeals were reargued before the Third Circuit *en banc* together with reargument in a pending appeal (Frilette v. Kimberlin) taken from the District Court for the District of Delaware. On December 16, 1974, the Third Circuit *en banc*, Judges VanDusen and Adams dissenting, rendered its opinion and judgment on rehearing (A-15) in the reargued appeals, holding:

> "To 'bite the bullet' is an old phrase currently enjoying a revival in popularity. It aptly describes our actions in these appeals as we overrule our prior holding in In Re Natta, 388 F.2d 215 (3rd Cir. 1968), which erroneously gave a broad interpretation to 35 U.S.C. § 24 (1952). It is our conclusion that the statute does not grant broad discovery authorization to the district courts in patent interference cases but limits ancillary jurisdiction to the issuance of subpoenas as permitted by prior practice." (A-17-18)

Duffy moved the Court to correct and to amend the foregoing opinion and judgment on rehearing; on January 27, 1975, the Third Circuit entered an order materially amending its opinion (A-54-57) and rendered an amended judgment on rehearing (A-58), but the decision of the Court respecting the interpretation of 35 U.S.C. § 24 was not altered.

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[10] It was at that time well settled in the Third Circuit and elsewhere that an order granting or denying discovery under 35 U.S.C. § 24 is a final, appealable order. Babcock & Wilcox Co. v. Foster Wheeler Corp., 415 F.2d 777, 778 (3rd Cir. 1969).

REASONS FOR GRANTING THE WRIT

I. The Decision Below Squarely Conflicts with the Decisions of Every Other Court of Appeals that has Interpreted 35 U.S.C. § 24

The decision below directly and irreconcilably conflicts with the decisions of four Courts of Appeals and of the district courts in three additional Circuits and overrules like precedent followed in the Court below for seven years respecting the jurisdictional boundaries of the federal courts under an important and frequently exercised statute, 35 U.S.C. § 24.

The conflict creating impact of the decision below is ably summarized in the dissent of Judge Adams:

> "Section 24 was enacted in 1952. In 1968 this Court, in *Natta,* interpreted the intent of Congress, as expressed in the statute, as follows: 'This statute manifests a clear congressional intent to make available to parties to patent interferences the broad discovery of the Federal Rules of Civil Procedure.'[3] The *Natta* Court's construction of section 24 conformed to prior interpretations by the Courts of Appeals for the Fifth[4] and Seventh[5] Circuits and by the District Courts for the Western District of Michigan[6] and the Northern District of Oklahoma[7]. Subsequent to our decision in *Natta,* the same interpretation has been adopted by the Courts of Appeal for the Tenth[8] and Second[9] Circuits, and by the District Courts for the District of Columbia[10] and the District of Massachusetts.[11] And this Court has applied its *Natta* interpretation of the statute on a number of occasions.[12] Indeed, no court of appeals has adopted a narrower reading of section 24 than that set forth in *Natta.*" (A-38-39—footnotes omitted)
>
> • • •
>
> "In overruling *Natta,* the majority rejects the construction of section 24 which, as previously noted, has been

accepted by every court of appeals that has considered the question." (A-50—emphasis supplied)

Since the decision below was made by the Court *en banc* and overruled precedent of seven years standing and since a contrary interpretation of 35 U.S.C. § 24 has been repeatedly and uniformly followed in every other Circuit that has considered the question, it is respectfully submitted that the conflict between the Circuits is so rigidly cast as to be only resolvable by this Court. Indeed, the District Court for the District of Massachusetts in an action filed under 35 U.S.C. § 24 and involving the very parties to this petition has already expressly declined to follow the holding of the decision below. *Barnes et al.* v. *Duffy,* F. Supp. , U.S.P.Q. (1974).

II. The Conflict Between the Circuits Respecting the Jurisdiction Conferred by 35 U.S.C. § 24 May Result in "Serious Injustice"

The pragmatic impact of the decision below on future litigants is forecast in the dissent of Judge Adams:

> "Therefore the extent of discovery available to Patent Office litigants will hereafter depend upon the fortuity of the location of the evidence sought to be discovered, since only within the Third Circuit will discovery be confined to the limited discovery available administratively. This lack of homogeneity among the courts of appeal may result in *serious injustice* where disclosure of one party's evidence is controlled by the law of this Circuit, while divulgence of that of the adversary party is governed by the decisions of another Circuit." (A-50—emphasis supplied)

The prediction of Judge Adams as to the adverse consequences attendant one-sided discovery is not overstated. This Court has repeatedly emphasized the importance of the

federal discovery rules to making "a trial less a game of blind man's buff and more a fair contest with the basic issues and facts disclosed to the fullest practicable extent". *United States* v. *Procter & Gamble Co.*, 356 U.S. 677 at 682-683 (1958); *Hickman* v. *Taylor*, 329 U.S. 495, 501 (1947). The significance of the federal discovery rules to the integrity of the adversary process, and particularly to the objective "quest for truth"[11] cannot be gainsaid. The intolerable conflict and potential for "serious injustice" created by the decision below can only be resolved by this Court.

The public interest policy of patents as stated in numerous decisions of this Court is an added and crucial reason supporting the need for review of the decision below. Indeed, it is prophetic that this Court in finding several patents to be unenforceable because of the withholding of crucial facts from the Patent Office *in an interference proceeding*, stated:

> "Public interest demands that all facts relevant to such matters [possible fraud or inequitable conduct] be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in that way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud.'" *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806,818 (1945)—matter

[11] The Seventh Circuit Court of Appeals and the Third Circuit, in a decision preceding the contrary holding below, have held that the ancillary jurisdiction to order discovery in Patent Office interference proceedings as conferred by 35 U.S.C. § 24 should be exercised by the Courts in a manner "to cooperatively complement Patent Office jurisdiction as an aid to the quest for truth". Natta v. Zletz, 379 F.2d 615 at 618 (7th Cir. 1967); Babcock & Wilcox Co. v. Foster Wheeler Corp., 432 F.2d 385, 387 (3rd Cir. 1970).

in brackets added; see also, *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U.S. 238 (1944) and *Keystone Driller Co.* v. *General Excavator Co.*, 290 U.S. 240 (1933). cf. *Mercoid Corp.* v. *Mid-Continent Invest. Co.*, 320 U.S. 661,665 (1944).

A former Commissioner of Patents in interpreting the Supreme Court decision in *Precision, supra,* observed:

> "It is clear from these statements that the Court was of the opinion . . . that the Patent Office is the proper agency to prevent, in the first instance, the grant of such a monopoly." *Ex parte Mallard,* 71 U.S.P.Q. 294, 296.

Certainly, the Patent Office cannot discharge the responsibility mandated by this Court to prevent fraud or other inequitable conduct, in the present or in future cases, unless it is afforded a complete fact record. But necessarily, the Patent Office (as well as any other adjudicative tribunal) must rely upon the litigants for development of a complete fact record. The interpretation of 35 U.S.C. § 24 applied below, unlike that of "every other court of appeals that has considered the question", (A-50) frustrates a litigant's access to information essential to formulation of a complete fact record and, thus, frustrates implementation of the public interest patent policies enunciated by this Court. Accordingly, the issue of the correct interpretation of 35 U.S.C. § 24 is a matter of exceptional importance having a substantial impact on the public interest. For this reason alone, it is urged that certiorari should be granted to review the decision below.

III. The Decision Below Constitutes an Unconstitutional Abandonment of Compulsory Jurisdiction Under 35 U.S.C. § 24

From the first section of this Petition, it is apparent that the overwhelming weight of judicial authority supports the conclusion that the federal courts are invested by Congress with an obligatory jurisdiction under 35 U.S.C. § 24 to con-

sider on their merits applications for discovery in pending Patent Office interferences. Only the decision below departs from this view.

District Judge Coolahan in explicating the obligations imposed upon the federal courts by 35 U.S.C. § 24 has observed that these jurisdictional duties are of Constitutional dimension and cannot be avoided:

> "The district court may not defer to the Board[4] by declining to exercise its jurisdiction under 35 U.S.C. § 24, as it has always been the law that federal courts may not refuse jurisdiction conferred by the Constitution and statutes of the United States.[5]"
>
> • • •
>
> "5. Cohens v. Virginia, 19 U.S. (6 Wheat.) 264 (1821), in which Chief Justice Marshall, with characteristic vigor and directness, ruled that the Supreme Court 'must take jurisdiction, if it should.' • • • We have no more right to decline the exercise of jurisdiction which is given, than to usurp that which is not given. The one or the other would be treason to the constitution.' Id. at 404." *Babcock & Wilcox Co.* v. *Foster Wheeler Corp.*, 173 U.S.P.Q. 480 at 483 (D.N.J. 1972)—all but footnote 5 omitted.

This Court should review the decision below since on the present record there is a strong possibility, if not probability, that the decision below constitutes an unconstitutional abandonment of compulsory jurisdiction under an important federal statute.

IV. The Decision Below Improperly Overrides the Doctrine of *Stare Decisis* and Violates the Constitutional Mandate Respecting Separation of Legislative and Judicial Powers

Both points of this section are ably stated by Judge Adams in his dissent in the cause below (A-39-47).

A course once charted in the law, and particularly one joined in without exception by a substantial number of other federal courts over a period of years and respecting a subject as immutable as a federal statute, is not under the venerable doctrine of *stare decisis* to be departed from by an intermediate federal court except in the most extraordinary circumstance. Stability, a keystone of our legal system, is jeopardized by any other rule. But where the instability has been generated, as here, it is critical that this Court take jurisdiction to set the matter at rest.

The Constitution imposes an added, rigid restraint upon the varying of a settled judicial interpretation of a federal statute. As again stated by Judge Adams in his dissent in the cause below:

> "The constitutional doctrine of the separation of powers lends added significance to the principal of stare decisis in the area of statutory construction. In deciding *Natta* in 1968, this Court was called upon to construe the congressional intent expressed in section 24. Our interpretation then became an integral part of the statute. When a court has once determined the meaning Congress intended its words to carry, the court has completed its judicial function." (A-26-27 —footnotes omitted)

Legislation by judicial fiat is of even greater concern where, as here, the statutory provision has been under review by Congress for almost seven years, and no change has as yet been made in the statute's wording. (A-42)

The only adequate remedy for the present situation is, as observed by Judge Adams, "Supreme Court review" (A-28).

CONCLUSION

For all of the reasons stated, it is respectfully requested that this Court grant the present petition for a writ of certiorari to the Third Circuit Court of Appeals to review the decision below.

Respectfully submitted,

JAMES P. HUME
GERALD D. HOSIER
HUME, CLEMENT, BRINKS,
WILLIAN, OLDS & COOK, LTD.
One IBM Plaza—4100
Chicago, Illinois 60611
312/822-9800

Counsel for Petitioner

Of Counsel:

RICHARD B. MEGLEY
BENJAMIN C. POLLARD
USM CORPORATION
Balch Street
Beverly, Massachusetts 01915
617/927-4200

APPENDIX

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

RICHARD J. DUFFY, :

Plaintiff, :

v. : Civil Action No. 822-73

GERALD BARNES and JOSEPH R. PREZIOSI, : OPINION LETTER

Defendants. :

July 10, 1973

Howard Danzig, Esq.
Riker, Danzig, Scherer & Brown, Esqs.
744 Broad Street
Newark, New Jersey 07102

John C. Lifland, Esq.
Stryker, Tams & Dill
33 Washington Street
Newark, New Jersey 07102

RE: Richard J. Duffy v. Gerald Barnes et al., Civil Action No. 822-73

Gentlemen:

Today was the return date of defendants' motion to quash subpoenas duces tecum and to vacate notice of taking depositions and inspection of documents and things. Defendants' motion arises from plaintiff's earlier notice served in accordance with 35 U.S.C. §24, which permits ancillary discovery in patent interferences by way of

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the Federal Rules of Civil Procedure in the appropriate federal district court.

As the earliest applicant for a patent for the invention in question herein, plaintiff Richard Duffy was assigned the position of senior party in Interference 97,945. Gerald Barnes and Joseph Preziosi are the junior parties to the interference.

This interference has not yet moved past the motion period. It was during this time that the junior applicants moved before the Interference Examiner, pursuant to Rule 241(a)(5), Patent Office Rules of Practice, for leave to amend their application by deleting the name of Barnes as a co-inventor. It was argued that the junior applicants had only recently discovered that Preziosi was in fact the sole inventor.

Duffy, the senior applicant, opposed the motion of the junior to amend their application as to inventorship on the ground that the affidavits submitted in favor of the proposed amendment did not show "error without any deceptive intention" or "diligence" in discovering and correcting the purported error, as required by 35 U.S.C. §116 and Rule 45(b), Patent Office Rules of Practice. Duffy's opposition was based upon alleged material discrepancies between facts sworn to in the original, unamended application and those later set forth and sworn to in the junior's preliminary statement, required by Rule 215, et seq., Patent Office Rules of Practice.

Apparently, the junior applicants had taken the tact of submitting a preliminary statement in the name of Preziosi alone,

in the knowledge and realization that the proofs during the testimony period would reveal him to be the sole inventor, and in the hope that the Interference Examiner would invoke his discretion in their favor to allow amendment of the application to correspond with the preliminary statement subsequently filed. However, being of the opinion that the junior's application rather than their preliminary statement correctly stated the case, Duffy opposed the application amendment.

On May 17, 1973 the Interference Examiner rendered his decision denying the motion to delete the name of Barnes as an inventor from the application. The Examiner ruled that the evidence adduced by subsequent affidavit in the preliminary statement of the junior party was merely "generalized assertions and conclusions" and insufficient to demonstrate error without deceptive intent as well as diligence in correcting that error within the meaning of 35 U.S.C. §116 and Rule 45(b), Patent Office Rules of Practice.

The decision of the Examiner has left the junior party in a precarious position. While their application, which the Examiner ruled could not be amended, named both Barnes and Preziosi as inventors, the preliminary statement named Preziosi alone as the inventor. Obviously, the junior party at some time reviewed its case and realized that the proofs during the testimony period could not bear out Barne's part in the invention for which a patent was being sought. It was apparently deemed wise to file a preliminary statement in accord with the facts known then and to move later before

the Examiner for leave to amend the application so as to correspond to the subsequently filed preliminary statement. However, once the Examiner refused to permit such an amendment, the junior party was left with a preliminary statement at direct odds with its application as to inventorship.

Rule 215(a), Patent Office Rules of Practice, requires each co-inventor to sign and swear to the preliminary statement; otherwise, it will be deemed ineffective. If no preliminary statement is "effective," i.e., filed, Rule 223(c), Patent Office Rules of Practice, sets the date of invention at the date of application. Since the junior party was by definition the later applicant in the interference, it follows that its date of invention could not possibly precede that of Duffy, the senior party to the interference, even if Duffy's date of invention were also the date of application. Therefore, if the decision of the Examiner disallowing amendment of the junior party's application is upheld by the Interference Board, it would appear that the junior party's application must be dismissed.

It was precisely this line of reasoning which led the Interference Board to issue, sometime very shortly after the decision of the Examiner had been rendered, an order to show cause why the application of the junior party should not be dismissed. This is an ex parte proceeding in which the senior party would advance arguments but would not actively participate. The return date of the order to show cause was adjourned indefinitely, however, until the Interfer-

ence Board had had an opportunity to review the ruling of the Examiner.

This much should serve as an adequate background for the senior party's ancillary action for discovery pursuant to 35 U.S.C. §24. Duffy sought to depose both Barnes and Preziosi as well as several scientific aides who worked along with them, and also sought the production of documents, records and other things appertaining to the claimed invention. The junior party seeks an order of this Court quashing the subpoenas directing the junior party's staff to appear for the taking of depositions as well as an order vacating the notice of taking depositions and for the production of documents and things.

The junior party objects to the proposed discovery as premature and cites for support the recently adopted discovery rules of the Patent Office found in Rule 287, Patent Office Rules of Practice. Even a cursory review of Rule 287 reveals that the discovery practice anticipated by that rule bears directly on preparation for the testimony period. Not only the language of the rule, but also the nature of the discovery allowed and the timetable set forth for discovery, leads to the conclusion that Rule 287 concerns itself solely with discovery as to the merits of the interference.

The senior party does not, however, seek discovery which goes to the merits of the case, that is, to the issue of priority of invention. Based upon the palpable discrepancies in the junior party's application and preliminary statement, and believing the former to be the product of willful

falsehood, Duffy moves for discovery in the hope of successfully advancing a motion pursuant to Rule 56, Patent Office Rules of Practice, to strike the application of the junior party as fraudulently filed. Obviously, this is an issue aside from that of priority.

It is true that this Court has said that parties to an interference should be given every encouragement to seek discovery first in the Patent Office under its newly issued discovery regulations set forth in Rule 287. See Babcock & Wilcox Co. v. Foster Wheeler Corp., 173 U.S.P.Q. 480 (D.N.J. 1972). However, that decision and similar, recent rulings denying discovery as premature because the Interference Examiner and Board had not ruled on the matter, such as Filette [sic] v. Kimberlin, BNA Patent, Trademark & Copyright J., No. 129 (D. Del. 1973), dealt only with discovery relating to the merits of the interference, that is, with the proofs which would be offered during the testimony period. Duffy's anticipated motion under Rule 56, Patent Office Rules of Practice, to strike his adversary's application as fraudulent does not reach the merits of the interference.

True, much of the material and testimony sought by Duffy to be discovered overlaps into the area of discovery permitted or even required by Rule 287, and Duffy could again renew his request for discovery pursuant to the Federal Rules of Civil Procedure before this Court should the Examiner at an appropriate time deny such discovery requests as are discretionary under Rule 287. True, also, a Rule 56 motion to strike

an application for fraud may be made at any time in the interference proceedings.

But where a party alleges defects of a technical or procedural nature which would preclude or obviate a hearing on the merits, common sense dictates that the ultimate issue of priority should await disposition of the preceding allegations. And since it is still the general rule that a party to an interference may gain discovery through the federal courts by way of 35 U.S.C. §24 and the Federal Rules of Civil Procedure at any stage of the interference. Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968); In re Natta, 388 F.2d 215 (3rd Cir. 1968); Natta v. Zletz, 379 F.2d 615 (7th Cir. 1967), there appears to be no good reason why Duffy ought not to be able to push forward with his Rule 56 motion by obtaining the discovery he presently seeks before this Court. Moreover, this discovery would run concurrently with the resolution of the appeal now pending before the Interference Board as to the motion of the junior party to amend its application. Thus, this discovery would take little if any additional time.

For the above stated reasons, the motion of the junior party Barnes and Preziosi to quash subpoenas and vacate notice of taking depositions and for the production of documents and things will be denied.

Prevailing counsel may submit an appropriate order.

Yours very truly,
/s/ James A. Coolahan
JAMES A. COOLAHAN
United States District Judge

JAC:rmr

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

RICHARD J. DUFFY, Plaintiff,	:	
v.	:	Civil Action No. 822-73
GERALD BARNES and JOSEPH R. PREZIOSI, Defendants.	:	ORDER

This cause having come on to be heard on defendants' motion Under Rules 26(c) and 45(b) to quash Subpoenas duces tecum duly served on Messrs. Charles C. Faroni, Richard C. Baubles, Donald Sager, William F. McGuinness, James B. Duke and Richard Craig and to vacate Requests for Production of Documents and Things directed to Messrs. Gerald Barnes and Joseph R. Preziosi and further to vacate a Notice of Taking Depositions of all of the aforementioned individuals, and the Court having considered the briefs of the parties, having heard oral argument thereon on July 10, 1973, and having rendered an opinion by letter dated July 10, 1973, it is on this 24th day of July, 1973,

ORDERED that, pursuant to Rule 37,

(1) The foregoing motions of defendants be and they hereby are denied and the discovery sought by plaintiff pursuant to the aforesaid Subpoenas duces tecum, Requests for Production of Docu-

ments and Things and Notice of Taking Depositions is granted;

(2) Each and all of the aforementioned Subpoenas duces tecum be and they hereby are made returnable in accordance with their respective terms on July 31, 1973 at 10 a.m. at the offices of plaintiff's counsel, Stryker, Tams & Dill, 33 Washington Street, Newark, New Jersey;

(3) Defendants shall comply with the terms of the aforesaid Requests for Production of Documents and Things on or before July 31, 1973 at the said offices of plaintiff's counsel, at the offices of defendants' counsel (Riker, Danzig, Scherer & Brown, 744 Broad Street, Newark, New Jersey), or any other place mutually agreeable to the parties; and

(4) The effective date of the plaintiff's aforesaid Notice of Taking Depositions shall be and hereby is made July 31, 1973.

(5) The defendants' motion for a stay is denied.

/s/ James A. Coolahan
U.S.D.J.

We consent to the form hereof.

RIKER, DANZIG, SCHERER & BROWN
Attorneys for Defendants

By /s/ Howard Danzig
Howard Danzig

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

RICHARD J. DUFFY,	:	
Plaintiff,	:	
v.	:	Civil Action No. 822-73
GERALD BARNES and JOSEPH R. PREZIOSI,	:	MEMORANDUM AND ORDER
Defendants.	:	

COOLAHAN, District Judge:

On July 12, 1973 this Court filed an Opinion permitting the taking of discovery pursuant to the ancillary relief allowable under 35 U.S.C. §24 on behalf of plaintiff Richard Duffy, senior party to Patent Interference No. 97,945. In granting such relief, the Court noted that plaintiff did not seek "discovery which goes to the merits of the case, that is, to the issue of priority of invention. Based upon the palpable discrepancies in the junior party's application and preliminary statement, and believing the former to be the product of willful falsehood, Duffy moves for discovery in the hope of successfully advancing a motion pursuant to Rule 56, Patent Office Rules of Practice, to strike the application of the junior party as fraudulently filed."

In accordance with the Opinion of the Court, an order was entered denying defendants' motion to quash subpoenas duces tecum and vacate notice for the taking of deposi-

tions and for the production of documents and things. Defendants were enjoined to comply with the discovery demanded by plaintiffs, but only to the extent ordered in the July 12th Opinion of the Court.

On appeal to the Third Circuit, defendants obtained an order from that court denying a motion to stay the discovery proceedings insofar as they relate to plaintiff's Rule 56 application in the Patent Office, but granting a stay of this Court's order insofar as it permits discovery relating to the ultimate question of priority of invention. In issuing this order, the Third Circuit cited and relied upon language of the District Court's Opinion which made this very distinction.

Although not specifically recited in the Court's Order entered July 24, 1973 permitting limiting discovery as to whether defendants had fraudulently filed a patent application, it is clear from the earlier Opinion that this distinction between facts relating to plaintiff's Rule 56 motion in the Patent [Office] and facts relating to the merits, i.e., the issue of priority of invention, was to be maintained. Quite obviously, these issues overlap significantly and strict boundaries cannot be neatly kept. The Court is of the opinion that as to any question of relevancy, any doubt ought to be resolved in favor of discoverability. The Court does not interpret the stay of the Third Circuit against discovery running to the merits to apply, therefore, to any area of discovery which is coincidentally relevant to the issues pressed by plaintiff by way

of his Rule 56 motion in the Patent Office.

It appears that during the period of discovery in the instant case, defendants supplied plaintiff with several selected documents which they deemed relevant to the issue of fraudulent filing, which documents in turn referred to other documents which defendants have refused to produce on the ground that they contain facts which go [sic] the issue of priority. If such documents bear any relevance at all to the matter held discoverable by the Court heretofor, production should be made forthwith. If counsel should deem a protective order or other relief necessary, that will be a matter for the Court to take up at some appropriate time. However, the discovery should proceed and the documents produced. Therefore, insofar as the Court of Appeals has stayed discovery which bears upon the merits of this patent action alone and without relevance to plaintiff's Rule 56 motion, its order anticipates an area of discovery which the District Court has not permitted.

The Court is reluctant to take on the responsibility of ruling document by document the permissibility of discovery, and it is hoped that the parties may in good faith resolve their differences in the spirit dictated by the July 12th Opinion of the Court as well as the Memorandum and Order herein entered.

The effectiveness of this Order shall be stayed for ten (10) days from the date

of entry so that defendants may appeal therefrom if they so desire.

IT IS SO ORDERED.

/s/ James A. Coolahan
United States District Judge

Dated: August 6, 1973

IN THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 73-1635 and 73-1695

RICHARD J. DUFFY,

Plaintiff-Appellee

v.

GERALD BARNES, JOSEPH R. PREZIOSI, WILLIAM F. McGUINNESS, JAMES B. DUKE, WILLIAM A. CRAIG, CHARLES C. FARONI, RICHARD BAUBLES and DONALD SAGER,

Defendants-Appellants.

(D.C. No. 822-73)

PRESENT: SEITZ, Chief Judge, VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS, and GARTH, Circuit Judges.

ORDER GRANTING REHEARING IN BANC

A majority of the active judges having voted for rehearing in banc in the above matter, it is ordered that the Clerk of this Court list the above case for rehearing before the Court in banc at the convenience of the Court.

For the Court,

/s/Collins J. Seitz
Chief Judge

Dated: May 6, 1974

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

No. 73-1622

VINCENT J. FRILETTE, and PAUL R. WEISZ,
Movants

• • •

CHARLES N. KIMBERLIN, JR. and
ELROY M. GLADROW,
Opposers

VINCENT J. FRILETTE

and

PAUL R. WEISZ,
Appellants

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

(D.C. Misc. No. 83)

Argued February 15, 1974

Before VAN DUSEN and ADAMS, *Circuit Judges*,
and HUYETT, *District Judge*.

Reargued September 13, 1974

Before SEITZ, *Chief Judge*, VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, *Circuit Judges*.

Farrell R. Werbow, Esq. & Davidson C. Miller, Esq., Stevens, Davis, Miller & Mosher, Arlington, Virginia

and

Murray M. Schwartz, Esq. & Daniel A. Durkin, Esq., Murdoch, Longobardi, Schwartz & Walsh, Wilmington, Del.

Attorneys for Appellants

Of Counsel:
Thomas F. Reddy, Jr., Esq.
Pennie & Edmonds
New York, N.Y.

John J. Schlager, Esq.
Linden, N.J.

David F. Anderson, Esq., Potter, Anderson & Corroon, Wilmington, Del.

Attorneys for Appellee

Nos. 73-1635 and 73-1695

RICHARD J. DUFFY,

Plaintiff-*Appellee*

v.

GERALD BARNES, JOSEPH R. PREZIOSI, WILLIAM F. McGUINNESS, JAMES B. DUKE, RICHARD A. CRAIG, CHARLES C. FARONI, RICHARD BAUBLES and DONALD SAGER,

Defendants-*Appellants.*

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

(D.C. No. 822-73)

Argued January 9, 1974

Before ADAMS, HUNTER * and WEIS, *Circuit Judges*

Reargued September 13, 1974

Before SEITZ, *Chief Judge*, VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, *Circuit Judges.*

Of Counsel:
Richard B. Megley, Esquire
Benjamin C. Pollard
USM Corporation
Balch Street
Beverly, Mass. 01917

James P. Hume, Esquire
Gerald D. Hosier
Hume, Clement, Brinks, Willian, Olds & Cook, Ltd.
One First National Plaza
Chicago, Illinois 60670
Attorneys for Appellee

Of Counsel:
Prangley, Dithmar, Vogel Sandler & Stotland
105 West Adams Street
Chicago, Illinois 60603

Richard A. Craig, Esquire
Amerace Corporation
New York, New York 10017

Howard Danzig, Esquire
Riker, Danzig, Scherer & Brown
744 Broad Street
Newark, New Jersey 07102
Attorneys for Appellants

OPINION OF THE COURT

(Filed December 16, 1974)

WEIS, *Circuit Judge.*

To "bite the bullet" is an old phrase currently enjoying a revival in popularity. It aptly describes our action in these appeals as we overrule our prior holding in *In Re Natta*, 388 F.2d 215 (3d Cir. 1968), which erroneously gave a broad interpretation to 35 U.S.C. § 24 (1952). It is our

* Though Judge Hunter was not at oral argument, counsel, by consent, agreed to his participation in the decision and he reviewed the record of oral argument.

conclusion that the statute does not grant broad discovery authorization to the district courts in patent interference cases but limits ancillary jurisdiction to the issuance of subpoenas as permitted by prior practice.

These two appeals were argued together, and, while the fact situations differ, a common question of law governs the outcome of both cases. The relevant facts will be set out in abbreviated fashion, however, to give some background to the issues involved.

Both cases arise from interference proceedings filed in the Patent Office. This is an administrative process authorized by 35 U.S.C. § 135 (1962) to determine which of two or more applicants is the first inventor and thus entitled to a patent. The applicant first in time is called the senior party, and the other is designated the junior party. After all parties have filed preliminary statements presenting the grounds for their positions, a period of time is set by an examiner for the filing of motions. Thereafter, the Board of Patent Examiners establishes a time schedule designating when the parties must present their trial evidence by means of deposition, affidavit, or stipulation. The junior party is required to produce his evidence first, and the senior party follows.

In the preliminary stages of the *Duffy* case, the junior party filed a motion supported by affidavits. The motion was denied by the examiner and was then appealed to the Board of Patent Interferences. The senior party, without waiting for a decision on the appeal, applied to the district court in New Jersey for subpoenas *duces tecum* to compel discovery by depositions. After argument, the district court wrote an opinion [1] permitting discovery but limiting it to matters dealing with the veracity of the affidavits attached to the junior party's motion.

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1. The court's order was handed down on July 24, 1973, and an appeal was promptly filed in this court. A request for stay was filed on July 25, 1973, and denied on July 30, 1973. A second appeal was filed on August 14, 1973, together with a motion for clarification which was denied on August 22, 1973. Yet a third motion was filed in this court on October 12, 1973, seeking impoundment of evidence obtained by discovery. After argument, the motion was referred to another panel for disposition.

In the *Frilette* case, the junior party filed a request for discovery with the Patent Office pursuant to its Rule 287(c).[2] The motion was denied by the Board as being pre-

2. Pursuant to the authority granted by 35 U.S.C. § 23, Patent Office Rule 287, 37 C.F.R. § 1.287 was enacted effective June 11, 1971. It provides as follows:

"287. Discovery.

"(a) (1) Each party who expects to take testimony must serve on each opposing party who requests service the following:

"(i) A copy of each document in his possession, custody, or control and upon which he intends to rely,

"(ii) A list of and a proffer of reasonable access to things in his possession, custody, or control and upon which he intends to rely, and

"(iii) A list giving the names and addresses of all persons whom he intends to call as witnesses and indicating the relationship of each person to the invention in issue.

"(2) Dates for compliance with subparagraph (1) of this paragraph will be set in accordance with the following:

"(i) The date by which all parties may request service shall be not less than 10 days from the date of the order setting testimony times;

"(ii) The date for service by all junior parties shall be not less than 30 days from the date of the order setting such times;

"(iii) The date for service by the senior party shall be not less than 10 days from the date set for the close of testimony in chief of all junior parties.

"(3) Where more than two parties are involved and one of the junior parties is not entitled to take testimony as to a more senior party, the requirements of subparagraphs (1) and (2) of this paragraph shall not be applicable as between such parties.

"(b) The provisions of paragraph (a) of this rule are without prejudice to the right of a party, where appropriate, to obtain production of documents or things during cross-examination of an opponent's witness or during his own period for rebuttal testimony.

"(c) Upon motion (rule 243) brought by a party during the period for preparation for testimony, or thereafter as authorized under rule 245, and upon a showing that the interest of justice so requires, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority.

"(d) (1) A party will not be permitted to rely on any document or thing in his possession, custody or control, or on any witness, not listed and served by that party as required by paragraph (a) of this rule, except upon a promptly filed motion accompanied by the proposed additional documents or lists together with a showing of sufficient cause as to why they were not served by the date set pursuant to paragraph (a) of this rule.

"(2) Any failure to comply with an order under the provisions of paragraph (c) of this rule may be considered by the Board of Patent Interferences as basis for applying appropriate restrictions against the party failing to comply, for holding certain facts to have been established, and in an appropriate case for awarding priority against him, or for taking such other action as may be deemed appropriate.

mature since the time for filing documents by the senior party under Rule 287(a) had not yet expired. The junior party then applied to the district court in Delaware, which also denied discovery in an opinion holding that good cause had not been shown, and that the request was premature.[3]

This anomaly—permitting discovery in the district court while matters are still pending before an administrative agency—exists only in patent inferences. Generally, discovery is not available in administrative procedures. Davis, *1 Administrative Law Treatise* § 8.15 at 588 says:

> "The APA contains no provision for pre-trial discovery in the administrative process and, of course, the provisions of the Federal Rules of Civil Procedure for discovery do not apply to administrative proceedings. Therefore, in the absence of special statutory provision, and in the absence of special administrative regulation, no procedure for discovery is normally available in a federal administrative proceeding." [Footnote omitted]

Though there has been much criticism directed toward the absence of these procedures in administrative matters, little has been done to cure it except in the Patent Office. *See Davis, supra.*

The parties in these cases assert their right to secure discovery in the district court upon the authority of 35 U.S.C. § 24 which reads:

> "The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for

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2. (Cont'd.)

"(c) The parties may by agreement among themselves modify any of the foregoing requirements consistent with the schedule of times for taking testimony and filing the record. In the absence of such agreement, discovery will not be permitted prior to the period set for the preparation for testimony. (Added June 11, 1971)."

3. Frilette v. Kimberlin, 358 F. Supp. 493 (D.C. Del. 1973).

> any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

This statutory provision was interpreted by this court in *In Re Natta, supra,* to mean that Congress intended to include not only Fed. R. Civ. P. 45, pertaining to the attendance of witnesses and production of documents, but also the other rules of federal practice relating to discovery. The dissent by Chief Judge Seitz concluded that Congress had meant only to maintain the continuity of authority as granted to the courts under an earlier repealed statute pertaining to subpoenas and had not intended to incorporate the broad provisions relating to discovery generally. Essentially, the dissent reasoned that the courts were only to issue and enforce subpoenas in connection with the preparation of evidence for submission to the Board of Patent Interferences—the practice which had previously prevailed.

Prior to *Natta,* pretrial discovery, as such, was unknown in cases before the Board of Patent Interferences. The earlier cases of *Gladrow v. Weisz,* 354 F.2d 464 (5th Cir. 1965),[4] *Natta v. Zletz,* 379 F.2d 615 (7th Cir. 1967),[5] and *Korman v. Shull,* 184 F. Supp. 928 (W.D. Mich. 1960),[6]

4. The court held that a motion under Fed. R. Civ. P. 34 to produce documents by a party under cross examination would be allowed since the same result could be obtained by a subpoena *duces tecum.* The opinion did not purport to include all discovery rules.

5. A motion had been made by a senior party under Rule 34 for documents to use in connection with a cross examination of junior party employees on rebuttal testimony. Presentation of testimony was in process though the witness was not yet on the stand. Relying on Gladrow v. Weisz, *supra,* the court ordered production under Rule 34. Again, it seems that the material could have been secured by a subpoena *duces tecum.*

6. In this case a subpoena had been issued. By way of dictum and without any review of the history of 35 U.S.C. § 24, the district court held that Fed.

all involved instances where testimony was being prepared and subpoenas either had or could have been issued to compel production of documents. None of those cases actually involved pretrial discovery as that term is understood in the usual civil litigation.

The impact of the *Natta* decision was substantial. While the holding there, as in the earlier cases, applied to a situation where testimony was in progress, the dictum in that opinion was so broad that applications were soon made and granted where pretrial discovery was sought.[7] Because of the unique procedural posture of these cases, almost every order granting or denying discovery, no matter how routine in nature, became appealable.[8] The appel-

R. Civ. P. 26, 30, 34, and 45 were applicable. Subpoenas were ordered quashed because good cause had not been shown. Apparently, the subpoenas were issued in connection with presentation of testimony. However, in the later case of Korman v. Nobile, 133 U.S.P.Q. 178 (W.D. Mich. 1962), the same judge in passing upon another motion in the same interference proceeding said that the broad provision of the rules relating generally to discovery did not apply.

7. The opinion contained the statement that "This statute manifests a clear congressional intent to make available to parties to patent interferences the broad discovery provisions of the Federal Rules of Civil Procedure." 288 F.2d at 217.

In Sears, *Discovery in Interferences*, 53 Journal of the Patent Office Society 693 (1971), the author, one of the counsel appearing in the *Natta* cases, stated that "discovery" in proceedings before the adoption of the Federal Rules of Civil Procedure in 1937 was secured in connection with testimony to be presented as evidence at the trial. Since this evidence was in deposition form following the old equity practice, extremely wide latitude was extended to the concept of relevancy and materiality because the parties would not know in advance what rulings would be made at trial. This was a practical approach designed to avoid a remand for the taking of further testimony made necessary by unanticipated rulings at trial or on appeal and, of course, allowed "discovery" of information arguably irrelevant and immaterial which led to other evidence of more value.

As the author states candidly, "Perhaps unfortunately, some practitioners were motivated to go much further than the *Natta* cases did, or were ever intended to go, and to seek so-called '*pretrial* discovery' during the interference motion period regardless of their ultimate entitlement to present evidence in the interference."

In both cases at bar, discovery was sought in advance of the time set either for testimony or discovery as permitted by the new Patent Office rules. In *Duffy*, application was not made to the Patent Office, and in *Frilette*, application had been made and refused as premature.

8. The *Natta* case discussed here was but one of many growing out of discovery in Patent Interference 89,634. Not only was this circuit involved, but trial and appellate courts in other parts of the country were struggling with various aspects of discovery in that same interference proceeding, often at the same time. The following is a list, not warranted to be complete, of published opinions on various rulings: Montecatini Edison S.p.A. v. duPont

late bench thus was called upon to review, in this isolated field, discovery matters which would have been interlocutory in other fields of litigation where they would probably never receive attention in an appellate brief.

In addition to this substantial burden which was placed upon the traditional process of judicial administration, the liberalization of discovery engendered an interference all its own—one between the procedures in the Patent Office and those in the courts. The traditional timetable for submitting a case in the Patent Office and its concern for limiting the scope to relevant evidence were effectively neutralized if either party resorted to the federal courts for discovery in any or all stages in the interference proceedings. Instead of a role of "cooperatively complementing"[9] the Patent Office, the courts became the means through which the parties ranged far and wide, geographically as well as in terms of relevance, in search of evidence which, although not germane to issues in the Patent Office, might lead to other admissible evidence.[10] This, of course, all took time and disrupted the schedules of the Patent

8. (Cont'd.)
de Nemours & Co., 434 F.2d 70 (3d Cir. 1970); Natta v. Zletz, 418 F.2d 633 (7th Cir. 1969); In re Natta, 410 F.2d 187 (3d Cir. 1969), *cert. denied* 396 U.S. 836; Natta v. Zletz, 405 F.2d 99 (7th Cir. 1968), *cert. denied* 395 U.S. 909; Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968); In re Natta, 388 F.2d 215 (3d Cir. 1968); Natta v. Zletz, 379 F.2d 615 (7th Cir. 1967); In re Hogan, 309 F. Supp. 945 (D.C. Del. 1970); In re Natta, 48 F.R.D. 319 (D.C. Del. 1969); Hogan v. Zletz, 43 F.R.D. 308 (N.D. Okla. 1967), modifying Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968); In re Natta, 264 F. Supp. 734 (D.C. Del. 1967), *aff'd* 388 F.2d 215 (3d Cir. 1968); and In re Natta, 259 F. Supp. 922 (D.C. Del. 1966), *aff'd* 388 F.2d 215 (3d Cir. 1968).

9. Natta v. Zletz, 379 F.2d 615, 618 (7th Cir. 1967).

10. Even in the most complex antitrust litigation filed in the district court, the overwhelming majority of the matters similar to those appealed in the various patent interference cases would have been considered interlocutory and would have been concluded by the trial judge. Judge Coolahan commented on another unsatisfactory aspect in Babcock and Wilcox Co. v. Foster Wheeler Corp., 173 U.S.P.Q. 480, 481 (D.C. N.J. 1972), "A more undesirable plan for litigation could hardly be imagined, than that by which counsel must commute, often frantically and behind schedule, between the Patent Office and the federal district court in a time-consuming effort to exhaust discovery rights at the same time the interference trial has begun. When the district court decision is appealed, as it inevitably is, more delay occurs.

"The halving of legal decision-making between the Patent Office and the district courts has created friction between them."

Office with stays of proceedings in that agency while discovery proceeded in the courts.

Over the years the Patent Office has developed a procedure for handling these cases which required the junior party to present its evidence first. Discovery by the junior party in the district court prior to or while it presents its own case, however, frustrates the order of precedence which the Patent Office desires to utilize.[11] Whether that scheduling and priority are desirable is really not relevant, because they represent a choice by the agency responsible for processing these matters. The wisdom of the procedure is not entrusted to the courts.

Additional areas of conflict arose when the Patent Office ruled that certain discovery evidence which was secured in the courts would not be received in the Patent Office proceeding.[12] These conflicts between the Board of Patent Interferences and the court system would be serious enough if only one court were involved, but when several district courts and courts of appeals are concerned with different phases of the same litigation, the aggravations and delays become compounded.

Within the court system itself, the usual rules of confining control of the litigation to the principal forum become obscured and unworkable. Each district court has only the same interest in the outcome of the case as another. None has the decisional power in the final analysis; no one can guide and direct the parties toward some definitive goal. Although the matter ultimately will be submitted to the Patent Office, that agency cannot limit the activities or scope of discovery in the courts until that process has run its course. Interference proceedings thus lose the rudder that the court or agency which should have control over the case can provide.

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11. *Cf.* Dunner, Gambrell, and Kayton, 3 *Patent Law Perspectives*, 1970 Developments § C.4.

12. *See* Sears, *Discovery in Interferences, supra* at 701.

Even if no discovery at all is permitted in the Patent Office, the parties are not without a remedy. They still have a right of appeal to a district court under 35 U.S.C. § 146 (1952).[13] Such an appeal is *de novo*, and the full scope of discovery is permitted since the case then comes within the jurisdiction of the district court and the usual rules of procedure apply. But in such a situation the forum district does control the case, and orders on discovery are not appealable as of right but rather are interlocutory. Since the district court is familiar with the case, it is in a position to rule intelligently and promptly on the necessity of limitation or expansion of the scope of discovery in a particular case. There is an obvious improvement in judicial efficiency by having one court control the litigation.

Thus, the broad interpretation of Section 24 adopted by this court in 1968 established a procedural system which violated such tenets of good judicial administration as centralization of the litigation, disallowance of appeals on interlocutory and collateral matters, and primary jurisdiction. All repercussions were not negative, however. Spurred, no doubt, by the effects of the *Natta* decision, the Patent Office in 1971 chose to exercise the power to promulgate its own rules of discovery under the authority granted by Congress in 35 U.S.C. § 23 (1952). The Patent Office discovery rules, being limited in time and scope, are not as liberal as the Federal Rules of Civil Procedure but do represent an improvement over prior administrative practice.

The obvious disadvantages of the *Natta* discovery doctrine and the advent of the Patent Office discovery rules have prompted us to reconsider our holding in that case, rather than simply to accept it as binding precedent.

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13. The authors of Patent Law Perspectives argue that it might be better to transfer all the interference cases to the courts without going through proceedings in the Patent Office, unless adequate discovery means in district courts are made available. *See 3 Patent Law Perspectives*, 1973 Developments § C.4. Discovery in the Patent Office itself, however, seems to offer a more acceptable solution to the problem.

Despite its drawbacks, we would be bound by that rule had Congress in fact conferred such jurisdiction upon the courts, because we must recognize such jurisdiction as is granted by the legislative branch. The question is, did Congress in fact grant the jurisdiction which *Natta* thought to exist or did that conclusion come about only by erroneous construction and interpretation. We conclude that the latter is true.

In considering the words of the statute itself, two points are readily apparent. It does not use the word "discovery," nor is there any effort made to incorporate all of the federal rules of procedure. As Chief Judge Seitz pointed out in his *Natta* dissent, if Congress had meant to include discovery in its broad sense, such a substantial change in previous practice would naturally have been expected to be reflected in specific congressional recognition.[14] Not even the most enthusiastic advocates of the broad discovery made possible by *Natta* assert that all of the Federal Rules of Civil Procedure are included by transfer under Section 24.

Little would be served by repeating the excellent historical analysis of Section 24 set out in the *Natta* dissent. We simply adopt it at this time as the correct interpretation of the statute noting that, as is not unknown in judicial history, the opinion which was a dissent when rendered now becomes the law.[14a]

We do not lightly overturn precedent, and *stare decisis* must be treated with respect. But when on deep and mature

14. 35 U.S.C. § 23 was passed by Congress on the same day as Section 24 and is part of the same statutory package. It defies reasonable principles of statutory construction to hold that Congress specifically granted the Patent Office authority to enact rules of discovery under Section 23, while at the same time only inferentially extending the broad gambit of the Federal Rules of Civil Procedure on discovery to the courts in interference cases under Section 24.

14a. Judge Seitz's opinion in *Natta* reviews in detail the history of Section 24 and comes to a different conclusion than Judge Van Dusen's dissent in this case. It is because the majority believes that Judge Seitz correctly analyzed the statute that we now overrule *Natta*. The undesirable results of the *Natta* doctrine supply a background for reconsideration, not the reason for rejection of that case. If *Natta* had correctly interpreted § 24, the side effects would be worthy of note, but not grounds for disavowal of jurisdiction.

reconsideration it becomes apparent that an error has been made by the court, the proper step is correction. This is particularly so in a matter of procedure where no substantive rights are vested as a result of the earlier decision.

We do not believe it is necessary to wait for Congress to take the corrective action because the error was judge-made and the correction should be made in the same fashion. We cannot escape the fact that what has been done is in the nature of what, in the words of Chief Justice Hughes, might be called a "self-inflicted wound." We did not wait for congressional action to correct our mistake on "manufactured diversity" but took that step ourselves in *McSparran v. Weist*, 402 F.2d 867 (3d Cir. 1968), *cert. denied sub nom.*, 395 U.S. 903 (1969). The fact that Congress has under consideration several proposals to amend the patent statutes,[15] including provisions relating to discovery, similarly should not cause us to delay setting our own house in order.

We hold that 35 U.S.C. § 24 in referring to "provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents" refers to the matters encompassed by Fed. R. Civ. P. 45(a), (b), (c), (d)(2), (e) and (f).

The order in *Frilette v. Kimberlin* will be affirmed. The order in *Duffy v. Barnes* will be reversed.

VAN DUSEN, *Circuit Judge*, dissenting:

I respectfully dissent from the holding of the majority that 35 U.S.C. § 24, as worded in 1952, limits the ancillary jurisdiction of the district courts "to the issuance of subpoenas as permitted by prior practice." This holding is specifically stated by the majority at page 14:

15. S. 1321 and S. 2504 would give authority to the Patent Office to issue subpoenas and require the Commissioner of Patents to establish rules for discovery similar to those of the Federal Rules of Civil Procedure. S. 2930 requires issuances of subpoenas by the clerk of the District Court and provides that the Federal Rules of Civil Procedure as applicable to discovery shall apply.

"We hold that 35 U.S.C. § 24 in referring to 'provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents' refers to the matters encompassed by Fed. R. Civ. P. 45(a), (b), (c), (d)(2), (e), and (f)."

The majority opinion concedes at page 12 that we are "bound by" any jurisdiction conferred on the federal district courts by Congress.[1] The majority nevertheless appears to believe that district court jurisdiction, as mandated by the plain meaning of 35 U.S.C. § 24, is undesirable. Thus the majority disregards the following language, first included in § 24 by the Act of July 19, 1952, c. 950, § 1, 66 Stat. 795:

"The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

The plain or ordinary meaning of words used in a statute is applied in its construction. See *Banks v. Chicago Grain Trimmers Ass'n*, 390 U.S. 459, 465 (1968); *Malat v. Riddle*, 383 U.S. 569, 571 (1966); *Hughes v. Local No. 11*, 287 F.2d 810, 818 (3d Cir. 1961); *Hennesey v. Securities & Exchange Commission*, 285 F.2d 511, 515 (3d Cir. 1961). "The provisions of the Federal Rules of Civil Procedure" does not plainly mean only one of these Rules, namely, Rule 45, as decided by the majority. In addition to the plain meaning of the present statutory language, an analysis of the previous language and amendments thereto contradicts the majority's position. The applicable statutory language, as contained in Title 35 U.S.C. prior to the July 1952 Act, and the substitute language in 35 U.S.C. § 24 are set out as follows:

1. I do not disagree with the majority opinion's statement that the language of the majority in *In re Natta*, 388 F.2d 215 (3d Cir. 1968), gave an unjustifiably broad interpretation to the 1952 amendment to 35 U.S.C. § 24.

35 U.S.C. § 54 prior to July 19, 1952

"The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; *and the provisions of section 647, of Title 28*[2] *relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office.*" (Emphasis supplied.)

First paragraph of 35 U.S.C. § 24 after July 19, 1952

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*" (Emphasis supplied.)

2. The words "F.R. Civ. P. 45" had been substituted for "section 647 of Title 28" by the terms of 28 U.S.C. § 723b and c (Act of June 19, 1934, Ch. 651, 48 Stat. 1064, which was amended by Act of June 25, 1948, Ch. 646, 62 Stat. 961), which terms are now contained in 28 U.S.C. § 2072 as follows: "All laws in conflict with such rules shall be of no further force or effect after such rules shall have taken effect." Title 28, section 647, was repealed when F.R. Civ. P. 45 became effective in April 1938. See U.S.C.A. *Tables*, I, Revised Titles, at 43.

The reference to Rule 45 was effectively contained in the statute prior to the 1952 Act. Not only did the amending language alter this reference, but it also referred for the first time to the "provisions of the . . . Rules . . . relating to . . . the production of documents and things." These exact words were used in the title of Rule 34 as it existed in 1952. The title to this Rule, as amended in 1946,[3] read as follows in 1952:

> "Rule 34. Discovery and Production of Documents and Things for Inspection, Copying, or Photographing."

As opposed to this title, the titles and subtitles of Rule 45 read as follows:

> "Rule 45.
>
> "SUBPOENA
>
> "(a) For Attendance of Witnesses; Form; Issuance.
>
> . . .
>
> "(b) For Production of Documentary Evidence.
>
> . . .
>
> "(c) Service.
>
> . . .
>
> "(d) Subpoena for Taking Depositions; Place of Examination.
>
> . . .
>
> "(e) Subpoena for a Hearing or Trial.
>
> . . .
>
> "(f) Contempt.
>
> . . ."

According to the plain meaning of the words used in (a) 35 U.S.C. § 24, as amended in 1952, and (b) Rules 34 and 45, it seems clear that the words "The Federal Rules of Civil Procedure" referred at least to Rule 34 as well as Rule 45. Otherwise, Congress could have retained the

3. See page 13 of House Document 473, 80th Cong., 1st Sess.

wording of 35 U.S.C. § 54, merely substituting "Federal Rule of Civil Procedure 45" for "section 647 of Title 28."[4]

A. *Frilette Case*

In the *Frilette* case, during the preparations-for-testimony stage, prior to the commencement of the junior party Frilette's taking of testimony, Frilette filed a motion for discovery with the Board of Patent Interferences under Patent Office Rule 287(c), seeking certain information from Kimberlin. The Board of Patent Interferences denied the motion in a decision dated January 17, 1973, on the ground, *inter alia,* that the motion under 287(c) for additional discovery was premature "since the time for service of documents and lists by Kimberlin . . . , the senior party, under Rule 287(a) has not closed and in view of the fact that it is therefore not known what documents and lists will be served . . . ."

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4. See note 2 above. Congress might have hesitated to cite in § 24 a single rule of procedure, since the rules are not statutes and thus not subject to the closest congressional control over content and wording. Nevertheless, no reason appears why Congress would have failed to specify the provisions of the Rules of Civil Procedure relating to *subpoenas* had the intent been to limit the reference to Rule 45. Also, the legislative history of the 1952 Act shows that Congress changed the language of 35 U.S.C. § 24 as it first appeared in a draft bill to provide that "the provisions of the Federal Rules of Civil Procedure relating to *the attendance of witnesses and to the production of documents and things* shall apply to contested cases in the Patent Office. H.R. 9133 was introduced in the 81st Congress on July 17, 1950, and this bill was reintroduced in revised form in the 82nd Congress as H.R. 3760, which became the Patent Act of July 19, 1952 (P.L. 593, 82d Cong., 2d Sess., c. 950; 66 Stat. 792). H.R. 9133 contained this language in the last half of the last sentence of the first paragraph of 35 U.S.C. § 24:

> ". . . and the provisions of the Federal Rules of Civil Procedure relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office."

When this bill was reintroduced in revised form in the 82nd Congress as H.R. 3760, the last sentence of the first paragraph of proposed 35 U.S.C. § 24 had been changed to read:

> "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office."

The result of the many suggestions from the Patent Bar and the public concerning H.R. 9133 and the reintroduction of this bill in revised form in the 82nd Congress as H.R. 3760 is contained in House Report No. 1923, May 12, 1952. This history reveals the substitution for the words "the issuance of subpoenas duces tecum" of the words "the attendance of witnesses and the production of documents and things," which is the language appearing in the 1952 Patent Act.

Frilette also filed in the district court a motion to compel discovery under F.R. Civ. P. 37. In this motion, Frilette sought substantially the same discovery sought in the Patent Office, and requested an order compelling Kimberlin (1) to designate certain witnesses under F.R. Civ. P. 30(b)(6), (2) to answer certain interrogatories under F.R. Civ. P. 33, (3) to produce documents under F.R. Civ. P. 34, and (4) to admit certain facts under F.R. Civ. P. 36. A hearing on this motion was held before the district court, and, in an Opinion and Order dated May 15, 1973, the district court denied the motion. See *Frilette v. Kimberlin*, 358 F. Supp. 493 (D. Del. 1973).

Frilette appeals from this denial of his motion.

The district court, in denying Frilette's motion to compel discovery, stated that the law as previously enunciated should no longer prevail because of the recent occurrence of two events: (1) the 1970 amendments to the Federal Rules of Civil Procedure which eliminated the good cause requirement as a prerequisite to Rule 34 document requests, and (2) the introduction by the Patent Office in June 1971 of the discovery provisions of Rule 287.

With respect to the 1970 amendments, the district court stated:

> "Since the good cause requirement was apparently a factor in the federal courts' willingness to interpret § 24 broadly, this Court is unable to conclude that § 24 would have received a similar construction absent this safeguard. In such circumstances, it would not be unreasonable to continue to impose a good cause requirement under 35 U.S.C. § 24."

358 F. Supp. at 495-96. The district court went on to conclude that Frilette had not made a showing of good cause.

With respect to the recent introduction by the Patent Office of the discovery provisions of Rule 287, the district court stated that the absence of any discovery mechanism

in the Patent Office prior to the promulgation of Rule 287 had been a significant factor in the federal courts' willingness to give 35 U.S.C. § 24 a broad reading and to assume jurisdiction over discovery matters in interference proceedings. The district court felt that the introduction of the Patent Office discovery rules "appear[s] to reflect the Patent Office's efforts to construct a discovery process which embodies the good cause requirement cited" in such cases as *In re Natta, supra,* and that Rule 287 might, therefore, require a redefinition of the federal courts' role in granting discovery in interference proceedings under 35 U.S.C. § 24.

Based upon the above two considerations, the district court announced the following limitation on its role in interference discovery cases arising under 35 U.S.C. § 24:

> "While a federal court cannot abrogate its responsibility to assume jurisdiction under 35 U.S.C. § 24, it must not blind itself to the ancillary, supportive role, it is designed to fulfill in interference matters. Until the Patent Office has had a reasonable opportunity to implement its discovery procedures and has demonstrated the parameters within which they will be administered, the courts are in no position to evaluate the potential efficacy of the procedures and the possibility that the courts will be able to assume a secondary role in discovery. In light of these general considerations, the Court must scrutinize Frilette's particular discovery requests in light of the issues before the Patent Office."

358 F. Supp. at 496.

Frilette's primary contention on appeal is that, in light of the elimination by Congress in 1970 of the good cause requirement as a prerequisite to the grant of discovery under F.R. Civ. P. 34, the district court erred in judicially imposing a good cause requirement upon a party seeking discovery in an interference proceeding.

Specifically, Frilette claims that the district court's resurrection of the good cause requirement, on the ground that 35 U.S.C. § 24 would have received a different construction by this court in *Natta* and other courts absent the good cause safeguard, has no basis in logic. First, Frilette notes that good cause is not, and never was, a requirement of any of the discovery rules except F.R. Civ. P. 34, and that courts have granted discovery in patent interferences under such other discovery rules without regard to good cause. *See, e.g., Babcock & Wilcox Co. v. Foster Wheeler Corp.*, 54 F.R.D. 474 (D.N.J. 1971) (motion to compel discovery under F.R. Civ. P. 37). Secondly, Frilette contends that the reasons for the 1970 amendment of F.R. Civ. P. 34, eliminating the good cause requirement, apply with equal force whether the parties seeking discovery are parties to a Patent Office interference or litigants in a different type of civil proceeding.[5] Finally, Frilette contends that the application of a different standard to the scope of discovery under the Federal Rules when the interference is pending before the Patent Office would not only impair the Patent Office's quest for truth but also necessarily increase the number of suits in the district courts under 35 U.S.C. § 146 after decisions of the Board of Patent Interferences since, as the district court in the instant case noted, "on appeal to the district court from a decision by the Board of Patent Interferences, the movant may be entitled to broad discovery under the Federal Rules without any showing of good cause or other particular reason for the requested discovery." 358 F. Supp. at 498 n.7. Thus, Frilette argues, losing parties in interference proceedings are more inclined to bring a civil action under 35 U.S.C. § 146 if broader discovery is available in such civil action.

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5. The Advisory Committee's Note concerning the 1970 changes in F.R. Civ. P. 34 stated:

"Good cause is eliminated because it has furnished an uncertain and erratic protection to the parties from whom production is sought and is now rendered unnecessary by virtue of the more specific provisions added to Rule 26(b) relating to materials assembled in preparation for trial and to experts retained or consulted by parties."

See Moore's Federal Practice, Vol. 4A, ¶ 34.01[8] (2d ed. 1972).

I agree with these contentions and accordingly would hold that the district court erred in judicially imposing a good cause requirement upon discovery in patent interferences under 35 U.S.C. § 24. In 1970, Congress saw fit to permit the removal of the good cause requirement from the Federal Rules of Civil Procedure to become effective, and I perceive no logical reason why courts should carve an exception to such legislative action with respect to patent interferences. The district court, in resolving Frilette's request for discovery in the instant case, should have considered the same factors that it would consider in resolving a discovery request in any other civil proceeding.

One further aspect of this case requires discussion. As stated above, the district court, in addition to requiring Frilette to show good cause, stated that the Patent Office's recent promulgation of Rule 287 rendered distinguishable the *Natta* case and other cases which provided for broad discovery in the federal courts under 35 U.S.C. § 24. Reasoning that the presence of Rule 287 might require a restructuring of the federal courts' role under 35 U.S.C. § 24 and enable federal courts to assume a more limited, secondary role in interference discovery matters, the district court proceeded to "scrutinize Frilette's particular discovery requests in light of the issues before the Patent Office." 358 F. Supp. at 389. The district court then noted, in denying Frilette's motion, "that under Rule 287(a) and (c), Frilette's discovery directed to Kimberlin's case in chief is premature." *Id.* at 498. The district court did not make clear, however, whether its denial of Frilette's motion was based solely upon Frilette's inability to show good cause or also upon the Patent Office's prior denial of Frilette's motion as premature under Rule 287(a) and (c). Because of this uncertainty, I would remand to the district court for reconsideration of Frilette's discovery motion and, if necessary, clarification of its reasons for denial of such motion, in light of my belief

that the district court erred in requiring Frilette to show good cause.

Accordingly, I would not attempt to resolve definitively in this appeal the issue of what effect Patent Office Rule 287 has upon the availability of discovery under 35 U.S.C. § 24, particularly where the Board of Patent Interferences has denied a motion under Patent Office Rule 287 requesting the same discovery.[6] I have, however, substantial doubt as to whether the presence of Rule 287 compels a narrowing of the federal court's broad role in interference discovery proceedings under 35 U.S.C. § 24. Several factors underlie this doubt. First, on its face, Rule 287 provides for only limited discovery in the Patent Office. Under Rule 287(a), discovery is available prior to the testimony period solely for the purpose of determining the matters upon which the opponent will rely, not those which might build an affirmative case for the discovering party.[7] Therefore, Rule 287 does not provide for discovery as broad in scope as the discovery which may be provided by a district court under § 24. Secondly, Congress, presumably well aware of the conflict between the availability of broad discovery under 35 U.S.C. § 24 and the traditional order of proof procedure of interference proceedings,[8] repeatedly refused to amend 35

6. I recognize that in many cases it will be desirable for the parties to seek discovery first under Rule 287, but it is not necessary to make a definitive ruling on this point in this case. See *Frilette v. Kimberlin*, 358 F. Supp. 493-496 (D. Del. 1973). See also note 9, *infra*. Also, I believe that any discovery ruling by the Patent Office is a factor to be considered by the district court in ruling on a motion such as that presented to the district court in this case. *Cf. Laveson v. Trans World Airlines*, 471 F.2d 76 (3d Cir. 1972); *In re Natta*, 264 F. Supp. 734, 738 (D. Del. 1967).

7. While Patent Office Rule 287(c) provides that the Board of Patent Interferences may grant further discovery privileges at any time during the interference proceeding and to the full extent allowed under the Federal Rules, this power is discretionary and is not subject to interlocutory review. Moreover, Rule 287 applies only to the parties, so that no discovery of witnesses not under the control of the parties is available.

8. The traditional procedure in the Patent Office is that the parties present evidence in the inverse order of their filing date. Allowing the senior party to present its affirmative case after the junior party presents its affirmative case is intended to preserve the senior party's presumption that he is the first inventor. The discovery mechanism of Rule 287 is apparently designed to preserve this traditional procedure of maintaining the order of presenting proof by the parties.

U.S.C. § 24 to eliminate this conflict prior to the adoption of Rule 287 in June 1971.[9]

Finally, the language of 35 U.S.C. § 24 is mandatory, and it is questionable whether the Patent Office's promulgation of a narrow discovery rule can restrict the force and effect of such language. I believe that the district court should take the above factors into account in reconsidering Frilette's motion.

As a final matter, I reject the contention of appellee Kimberlin that the district court order denying Frilette's discovery motion was conditional rather than final, and that it was, therefore, not an appealable final order under 28 U.S.C. § 1291(a). See *Babcock & Wilcox Co. v. Foster Wheeler Corp.*, 415 F.2d 777 (3d Cir. 1969). In my view, the district court order was intended to be a final disposition of Frilette's motion for discovery.

I would vacate the May 15, 1973, district court order and remand the case to the district court for proceedings consistent with the foregoing views.

B. *Duffy Case*

As stated in Judge Adams' opinion, I agree that the district court did not abuse its discretion in allowing Duffy

9. Congress has on several occasions refused to enact bills which proposed a change in the language of 35 U.S.C. § 24 to read as follows:

> "(a) The clerk of any United States Court for the district wherein testimony is to be taken in accordance with regulations established by the Commissioner for use in any contested case in the Patent Office shall, upon the application of any party thereto, issue a subpena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office insofar as consistent with such regulations."

See S. 3892, 90th Cong. 2d Sess. § 24 (1968); S. 1246, 91st Cong. 1st Sess. § 24 (1969); S. 643, 92nd Cong., 1st Sess. § 24 (1971). These bills were introduced before the Patent Office adopted Rule 287. Other bills introduced before the adoption of Rule 287 proposed no change in the language of 35 U.S.C. § 24. See S. 1042, 90th Cong., 1st Sess. § 24 (1967); S. 2597, 90th Cong., 1st Sess. § 24 (1967); S. 2756, 91st Cong., 1st Sess. § 24 (1969); *cf.* also S. 2504 (Committee Print), 93rd Cong., 1st Sess., A Bill for the general reform and modernization of the Patent Laws, title 35 of the United States Code at Section 23(b)(1), p. 10, Section 135(c)(3), p. 45, and Section 145 at p. 51.

to proceed with discovery relating to whether Barnes and Preziosi filed their patent application fraudulently.

Judge Adams concurs in the statutory analysis set forth in this opinion and in the application of that analysis to the Frilette case.

ADAMS, *Circuit Judge*, dissenting:

The principal issue addressed on the rehearing in banc is whether we should now overrule *In re Natta*,[1] which decided that 35 U.S.C. § 24 [2] permits the parties to an interference proceeding pending in the Patent Office to obtain discovery in the district courts under the provisions of the Federal Rules of Civil Procedure.

I concur in Judge Van Dusen's careful analysis of the language and history of section 24, which indicates that it was reasonable for this Court to conclude in *Natta* that the reference in section 24 to the Federal Rules was intended to include the broad discovery procedures therein. I have some additional observations, however, regarding the respect a court should accord its earlier decisions, particularly a decision such as *Natta*, and regarding the practical effects that the holding announced today by the majority will have on interference litigation in the future.

I.

Section 24 was enacted in 1952. In 1968 this Court, in *Natta*, interpreted the intent of Congress, as expressed in the statute, as follows: "This statute manifests a clear congressional intent to make available to parties to patent interferences the broad discovery of the Federal Rules of Civil Procedure." [3] The *Natta* Court's construction of section 24 conformed to prior interpretations by the Courts of

1. 388 F.2d 215 (3d Cir. 1968).
2. 35 U.S.C. § 24 (1954).
3. 388 F.2d at 217.

Appeals for the Fifth [4] and Seventh [5] Circuits and by the District Courts for the Western District of Michigan [6] and the Northern District of Oklahoma.[7] Subsequent to our decision in *Natta*, the same interpretation has been adopted by the Courts of Appeal for the Tenth [8] and Second [9] Circuits, and by the District Courts for the District of Columbia [10] and the District of Massachusetts.[11] And this Court has applied its *Natta* interpretation of the statute on a number of occasions.[12] Indeed, no court of appeals has adopted a narrower reading of section 24 than that set forth in *Natta*.

The parties to these appeals who would have us upset our decision in *Natta* contend that the adoption of discovery procedures by the Patent Office in 1971 necessitates a reversal of this Court's interpretation of a congressional statute enacted in 1952.

II.

The basic issue before this Court is whether an intermediate federal appellate court that has for approximately seven years adhered to one interpretation of the congressional intent embodied in section 24 may properly adopt a new interpretation of that statute because of the actions of an administrative agency and the Court's present views regarding the optimal allocation of jurisdiction in the federal

4. Gladrow v. Weisz, 354 F.2d 464 (5th Cir. 1965).

5. Natta v. Zletz, 379 F.2d 615 (7th Cir. 1967).

6. Korman v. Shull, 184 F. Supp. 928 (W.D. Mich. 1960).

7. Hogan v. Zletz, 151 U.S.P.Q. 103 (D.C.N.D. Okla. 1966). *See also* Ochsner v. Millis, 382 F.2d 618 (6th Cir. 1967).

8. Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968).

9. Babcock & Wilcox Co. v. Combustion Engineering, Inc., 430 F.2d 1177 (2d Cir. 1968), *aff'd per curiam* 314 F. Supp. 235 (D. Conn. 1968).

10. Lomex v. Kihara, 175 U.S.P.Q. 538 (D.C. D.C. 1972).

11. Sheehan v. Doyle, 181 U.S.P.Q. 64 (D. Mass. 1973).

12. *See, e.g.*, Vogel v. Jones, 464 F.2d 573 (3d Cir. 1972); Babcock & Wilcox Co. v. Foster Wheeler Corp., 457 F.2d 1307 (3d Cir. 1972); Montecatini Edison S.p.A. v. E. I. duPont de Nemours, 434 F.2d 70 (3d Cir. 1970); Babcock & Wilcox Co. v. Foster Wheeler Corp., 432 F.2d 385 (3d Cir. 1970); Babcock & Wilcox Co. v. Foster Wheeler Corp., 415 F.2d 777 (3d Cir. 1969).

system. I believe that an appropriate respect for the doctrine of *stare decisis* and for the separation of judicial and legislative functions should preclude such a result.

Stare decisis is one of the fundaments of our legal system. All lawyers, I suppose, are familiar with the classic words of Lord Coke, "The knowne certaintie of the law is the safetie of all." [12a] Indeed, this aphorism is emblazoned on the walls of some of our most prestigious law schools.[13] The knowledge that a tenet of law, once decided, will remain constant permits the public to order their lives in reliance upon the prior decisions of the court.[14] In addition, observance of the precept of *stare decisis* advances the efficient administration of the judicial system. More significantly, a court's adherence to its earlier decisions encourages public confidence in the legal system by providing evidence that the court's holdings are the product of principled and carefully reasoned consideration and that the courts dispense equal treatment to all litigants similarly situated.[15] As Justice Brandeis observed, "Stare decisis is usually the wise policy, because in most matters it is more important that the applicable rule of law be settled than that it be settled right. This is commonly true even where the error is a matter of serious concern, provided correction can be had by legislation," [16] as it can in the case before this Court.

The constitutional doctrine of the separation of powers lends added significance to the principle of stare decisis in the area of statutory construction. In deciding *Natta* in 1968, this Court was called upon to construe the congres-

12a. *Coke, Institutes* 395 (12th ed. 1738) (Epilogue to Pt. 1, Bk 3).

13. Lord Coke's maxim is, for instance, inscribed along the ceiling of the Grand Stairway of William Draper Lewis Hall of the University of Pennsylvania Law School.

14. Hart & Sax, The Judicial Process 601.

15. *See* Boys Markets v. Local 770, Retail Clerks Union, 398 U.S. 235, 257 (1970) (Black, dissenting); Helvering v. Hallock, 309 U.S. 106, 129 (1970) (dissenting opinion).

16. Burnet v. Coronado Oil & Gas Co., 285 U.S. 393, 406 (1932) (dissenting opinion).

sional intent expressed in section 24. Our interpretation then became an integral part of the statute.[17] When a court has once determined the meaning Congress intended its words to carry, the court has completed its judicial function. Absent amendment, the legislative intent is not altered by time. Therefore, excepting extraordinary circumstances, a court, in altering its interpretation of the meaning to be derived from the words of the statute, encroaches on the power of Congress to enact or amend legislation.

> Of course, when this Court first interprets a statute, then the statute becomes what this Court has said it is. Such an initial interpretation is proper, and unavoidable . . . . The Court undertakes the task of interpretation, however, not because the Court has any special ability to fathom the intent of Congress, but rather because interpretation is unavoidable in the decision of the case before it. When the law has been settled by an earlier case, then any subsequent "reinterpretation" of the statute is gratuitous and neither more nor less than an amendment: it is no different in effect from a judicial alteration of language that Congress itself placed in the statute.[18]

If in construing a statute a court has misapprehended the intention of Congress, the error is susceptible to correction by the legislature. If this Court has failed to perceive the intent of Congress, or has interpreted a statute in such a manner as to thwart the legislative purpose, Congress may change it. "The lessons of experience are not learned by judges alone."[19] Statutory constructions are, in this respect, dissimilar from constitutional precedents, where the only alternative to overruling a judicial interpretation is the cumbersome procedure of constitutional

17. Gulf, Colo. & Santa Fe Ry. v. Moser, 275 U.S. 133, 136 (1927).

18. Boys Markets, *supra*, 398 U.S. at 257. (Black, dissenting).

19. Swift & Co. v. Wickham, 382 U.S. 111, 133 (Douglas, dissenting).

amendment. Courts should therefore exercise greater restraint in overruling statutory as distinguished from constitutional precedents.[20]

Additionally, when, as in the case before us, the allegedly erroneous statutory interpretation has been made by a court of appeals, Supreme Court review provides an additional remedy for an unsound construction.

A federal court should be particularly circumspect in setting aside its construction of a statutory provision which is still under review by Congress. In the interim since our decision in *Natta*, numerous unsuccessful attempts have been made in Congress to amend section 24. For example, prior to the Patent Office's promulgation of Rule 287, bills were introduced in 1968,[21] 1969[22] and 1971[23] seeking to amend the final sentence of the first paragraph of section 24 so as to provide that "the provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office *insofar as consistent with* [*Patent Office*] *regulations.*" (emphasis added) Other legislation introduced during the same period, however, proposed no changes in section 24.[24] Bills introduced since the promulgation of Rule 287 have offered a number of resolutions of the dual system of discovery available in the Patent Office and in the district courts. S. 2930[25] and H.R. 11868[26]—like the bills introduced in 1968, 1969 and 1971—provide that the Federal Rules of Civil Procedure

20. Boys Markets, *supra*, 398 U.S. at 259 (Black, dissenting); United Gas Improvement Co. v. Continental Oil Co., 381 U.S. 392, 406 (1965) (Douglas, dissenting); Burnet v. Coronado Oil & Gas Co., 285 U.S. 293, 406 (1932) (Brandeis, dissenting).

21. S. 3892, 90th Cong. 2d Sess. § 24 (1968).

22. S. 1246, 91st Cong. 1st Sess. § 24 (1969).

23. S. 643, 92nd Cong., 1st Sess. § 24 (1971).

24. *See* S. 2756, 91st Cong., 1st Sess. § 24 (1969). *See also* S. 1042, 90th Cong., 1st Sess. § 24 (1967); S. 2597, 90th Cong., 1st Sess. § 24 (1967). Both of the latter were proposed prior to our decision in *Natta* but subsequent to the earlier decisions, *supra*, to the same effect.

25. S. 2930; 93d Cong., 1st Sess. § 24 (1973).

26. H.R. 11868, 93d Cong., 1st Sess. § 24 (1973).

should apply to cases in the Patent Office only "insofar as consistent with Patent Office regulations established under section 23 of this title." On the other hand, S. 1321[27] and S. 2504,[28] although limiting the district court's jurisdiction

27. S. 1321, 93d Cong., 1st Sess. § 23 (1973):

Sec. 23. Issue of Subpenas and Other Orders by Patent Office, Review and Enforcement.

(a) Any party of record in any Patent Office proceeding may apply at any time to the primary examiner or other presiding official for subpenas or other orders to provide discovery, testimony, or evidence, and he shall issue the same *ex parte*. The primary examiner or any member of the Board of Appeals may also issue such subpenas or orders on his own motion, in any proceeding. Such subpenas and orders may issue against the applicant or any person within the jurisdiction of the United States, whether or not he is a party of record.

(b)(1) The Commissioner shall establish rules for taking such discovery, testimony, and evidence. Such rules shall provide the parties of record all discovery permitted and the sanctions for noncompliance therewith prescribed in the Federal courts pursuant to the Federal Rules of Civil Procedure, as procedural necessities within the Officer permit. * * *

(2) The Commissioner shall also establish rules governing *inter partes* proceedings by which subpoenas and orders issued pursuant to subsection (a) of this section may be sustained, quashed, or modified.

(c)(1) Agency action pursuant to subsections (a) and (b) of that section shall not be deemed final decisions or orders for the purposes of chapter 13 of this title. Judicial review of such order may be had upon review of the final decision or order in the entire proceedings. . . . Judicial review of agency action pursuant to subsections (a) or (b) of this section may also be had in the course of a civil enforcement proceeding. Such proceeding may be by way of application by any party aggrieved by refusal or failure to comply with a subpoena or order issued pursuant to subsections (a) or (b) of this section, to the United States District Court for the District of Columbia, for an order to show cause why the person refusing or failing to comply with such subpoena or order should not be commanded by the court to comply therewith.

28. S. 2504, 93d Cong., 1st Sess. § 23 (1973):

§ 23. Issue of subpoenas and other orders by Board of Examiners-in-Chief; review and enforcement

(a) Except as otherwise provided in section 135 of this title, any party to a proceeding before the Board of Examiners-in-Chief may apply at any time to any member of the panel for subpoenas or discovery orders to provide testimony, evidence, depositions, or other information, and such member shall issue the same ex parte. Any member of the Board of Examiners-in-Chief may also issue such subpoenas or orders on his own motion, in any proceeding. Subpoenas and orders may issue against the applicant or any person within the jurisdiction of the United States, whether or not he is a party in the proceeding.

(b)(1) The Commissioner shall establish rules for obtaining such discovery, testimony, evidence, depositions, or other information. Such rules shall provide the parties all discovery permitted, and the sanctions for noncompliance therewith prescribed, in the Federal courts pursuant to the Federal Rules of Civil Procedure, as now in force or as amended

in Patent Office cases, would require the Patent Office to provide discovery procedures substantially the same as those available in the district courts under *Natta*.

These various unsuccessful attempts to modify section 24 provide no clear signal that in *Natta* this Court erred in construing the legislative intent underlying that provision. Further, since some of these proposals are still under consideration by Congress, we should be wary of infringing on the authority of the legislative branch by seeking to accomplish by judicial fiat what Congress has contemplated doing, but so far has declined to do, through amendatory legislation.[29]

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28. (Cont'd.)
hereafter, with such different time limits as the Commissioner may by regulation prescribe. * * *

(2) The Commissioner shall also establish regulations governing proceedings by which subpoenas and orders issued pursuant to subsection (a) of this section may be sustained, quashed, or modified by the Board of Examiners-in-Chief.

(c)(1) Agency action pursuant to subsections (a) and (b) of this section shall not be deemed final decisions or orders for the purposes of chapter 13 of this title. Judicial review of orders pursuant to subsections (a) and (b) of this section may be had upon review of the final decision or order in the entire proceeding, ... Judicial review of agency action pursuant to subsections (a) or (b) of this section may also be had in the course of a civil enforcement proceeding. Such proceeding may be by way of application by any party aggrieved by refusal or failure to comply with a subpoena or order issued, and not quashed, pursuant to subsections (a) or (b) of this section, to the United States District Court for the District of Columbia, for an order to show cause why the person refusing or failing to comply with such subpoena or order should not be commanded by the court to comply therewith. * * *

29. It might be argued that the majority's action here in overturning its own interpretation of a federal statute is similar to the Supreme Court's conduct in Boys Markets v. Local 770, Retail Clerks Union, 398 U.S. 235 (1970). However, there are two significant distinctions between the situation presently before this Court and that in *Boys Markets*.

First, in *Boys Markets* Justice Brennan reasoned that the intervening decision in Avco Corp. v. Aero Lodge, 735, 390 U.S. 557 (1968), had undermined the Court's previous construction of the interrelationship between the Norris-LaGuardia Act and section 301(a) of the Labor-Management Relations Act. *Avco* "has produced an anomalous situation which in our view makes urgent the reconsideration of *Sinclair*. [370 U.S. 195 (1962)] The principal effect of *Avco* and Sinclair taken together is nothing less than to oust state courts of jurisdiction in § 301(a) suits where injunctive relief is sought for breach of a no-strike obligation." 398 U.S. at 244-45. Such result, Justice Brennan found, was inconsistent both with the Court's conclusion in *Dowd Box*, 368 U.S. 502 (1962)—that the purpose of section 301(a) was to supplement rather than to encroach upon the pre-existing jurisdiction of the state courts—and with the doctrine of the "federal policy of labor law uniformity" 398

III.

The social benefits derived from adherence to the doctrine of *stare decisis* and from the separation of the judicial and legislative powers mandate that a court cast aside its prior interpretation of statutory language only in extraordinary circumstances. In the present case, Judge Van Dusen's comprehensive discussion of the legislative history demonstrates that the *Natta* court's interpretation was certainly not unreasonable. In addition, the *Natta* opinion has not been undercut by subsequent decisions. Nor does *Natta* conflict with any previous, overriding, more fundamental policy of federal law.

The majority opinion in this case offers two justifications for overruling *Natta*. The first is the Patent Office's adoption of a rule providing limited discovery in the Patent Office. Nothing in section 24, however, makes the district court's jurisdiction dependent on the failure of the Patent Office to adopt discovery procedures. Moreover, the promulgation of a rule by an administrative agency subsequent to the enactment of section 24 could hardly alter the legislative intent embodied in the statute. Judicial estimation of the legislative purpose should not turn on the vagaries of an administrative agency in first rejecting, then accepting, and possibly again rejecting a procedural device. In addition, the statutory grant of authority under which the Patent Office adopted Rule 287 [30] predates this Court's decision in *Natta*. Recent recognition by the

29. (Cont'd.)
U.S. at 245-46, expressed by the Court in Lucas Flour, 369 U.S. 95 (1962). In contrast, our previous decision in *Natta* has been reaffirmed, rather than undercut, by our intervening decisions. *Compare* MacPherson v. Buick Motor Co., 217 N.Y. 382 (1916).

Second, the Supreme Court concluded that the earlier decision in *Sinclair* contravened one of the fundamental policies of federal labor law: "Thus because *Sinclair*, in the affirmation of *Avco*, casts serious doubt upon the effective enforcement of a vital element of stable labor-management relations—arbitration agreements with their attendant no-strike obligations—we conclude that *Sinclair* does not make a viable contribution to federal labor policy." 298 U.S. at 249. Our decision in *Natta*, on the other hand, does not conflict with any such overriding policy of federal law.

30. 35 U.S.C. § 23 (1954).

Patent Office of the practice of discovery, therefore, would not seem to justify a reversal of this Court's established reading of section 24.

The second justification advanced by the majority for redefining the congressional will underlying section 24 is what the majority regards as an undesirable burden on judicial administration brought about by broader discovery. The majority asserts that allowing Patent Office litigants discovery in the district courts increases the caseload in those courts. Also, since any discovery order becomes an appealable decision,[31] the courts of appeals are confronted with a spate of questions which in ordinary federal litigation would be considered interlocutory and therefore not subject to appeal. Furthermore, the majority states that there is no centralized control over the discovery proceedings, since an independent action may be brought in each district in which discoverable evidence is located. Concededly the above consequences flow in some degree from section 24, as interpreted in *Natta*. But jurisdiction in the federal courts is controlled by Congress, not by the judiciary. Courts may not refuse to exercise jurisdiction granted by statute even though such exercise might place additional burdens on the courts, and even though the courts may not agree with the procedures thus sanctioned.

Assuming, arguendo, that the inefficiencies generated by the *Natta* construction of section 24 exist and that they are as pernicious as they are portrayed by the majority, they may be remedied by Congress. The judiciary is not alone in possessing the insight to recognize impediments to efficient judicial administration. Also, the judicial branch is not as well equipped as the legislature to investigate the problem and to evaluate the potential resolutions.

The majority has apparently concluded that since some modicum of discovery is now available in the administrative agency, the federal judicial system would be

31. Babcock & Wilcox Co. v. Foster Wheeler Corp., 415 F.2d 777 (3d Cir. 1969).

operated most efficiently by removing, for all practical purposes, patent discovery proceedings from the district courts. But the majority's conclusion rests solely on its own theorization. The Court has no empirical evidence regarding the extent of the saving of judicial resources which could be achieved without discarding *Natta*. For instance, the courts may be able to reduce the volume of patent discovery litigation by clearly indicating that in the exercise of their discretion the district courts will refuse to grant discovery which is or will be available in the Patent Office unless the party seeking discovery can show substantial need for the discovery in the district court rather than in the Patent Office.

Nor does the record contain any evidence whether, accepting the *Natta* construction, discovery litigation could be reduced by imposing costs or other sanctions on recalcitrant parties. In addition, litigants dissatisfied with the outcome of interference litigation in the Patent Office may initiate a trial de novo in the district court,[32] where the full discovery provisions of the Federal Rules will, of course, be applicable. There is, however, no data available regarding the relative impact the majority's holding will have in reducing the judicial resources devoted to discovery in Patent Office cases as compared with the increase in district court time which will be expended on the de novo trial of interferences. Also, this Court does not possess the means to assess the extent to which this construction of the discovery available will alter the outcome of interference litigation.

Thus, neither the adoption of discovery procedures by the Patent Office nor the prospect of relief from the burden placed on the courts by the necessity of deciding discovery issues in administrative interference proceedings would appear to vindicate a reconsideration of the interpretation of section 24 that until today had been accepted by every Court of Appeals that had addressed the subject.

32. 35 U.S.C. § 146 (1954).

IV.

Even were the proposed justifications for reconsidering *Natta* more substantial, I would pause before repudiating that decision because of the effect the majority's ruling will have on the availability of discovery in proceedings in the Patent Office. The essence of the discovery provided by Rule 287(a) is that each party must provide his adversary with a copy of each document in his possession on which he intends to rely in presenting his case, and reasonable access to each "thing" on which he intends to rely, as well as a list of the witnesses he intends to call. Under 287(c) during the period for the preparation of testimony or thereafter a party may, upon a showing "that the interest of justice so requires," obtain additional discovery within the scope of the discovery rules of the Federal Rules of Civil Procedure, if the materials sought are within the control of the adverse party.

These Patent Office discovery procedures are in several notable respects more restricted than those available under the Federal Rules. First, the automatic discovery—discovery of right—applies only to that evidence on which the movant's adversary intends to rely. There is no discovery of materials which may bolster the movant's own case except at the discretion of the Board of Patent Interferences. In contrast, the Federal Rules make discovery of both supportive and detrimental evidence equally available.[33]

Second, in order to obtain discretionary discovery a party must demonstrate that "the interest of justice . . . requires" that he have access to the material. On the other hand, the Federal Rules require only that the material sought be "reasonably calculated to lead to the discovery of admissible evidence."[34] The standard that "the interest of justice so requires" appears to be a *more demanding test* than the requirement of "good cause" formerly con-

33. F.R.C.P. 26(b)(1).
34. F.R.C.P. 26(b)(1).

tained in Rule 34,[35] and even stricter than the requisite showing of "substantial need" for the disclosure of "work product."[36]

Third, the *scope of the materials* which Rule 287 authorizes the Board of Patent Interferences to order divulged may not be as broad as that available under section 24, as interpreted by *Natta*. It is doubtful whether Rule 287 provides for discovery relating to issues beyond the merits of the interference proceeding itself. In *Duffy v. Barnes*, for instance, the district court concluded that Rule 287 did not authorize discovery pertaining to existence of fraud in the filing of a patent application since a motion to have the application stricken pursuant to Patent Office Rule 56[37] is not within the ambit of an interference proceeding. At least under the trial judge's view of the scope of Rule 287, therefore, the majority's holding today will foreclose a party from obtaining discovery regarding the existence of fraud in the filing of a patent application.

Fourth, Rule 287 is more restrictive than the Federal Rules as to the *time* when discovery may be obtained. Rule 287(a) does not require the junior party to furnish the senior party with the specified discovery materials until after the close of the period set by the Board of Interferences for the consideration of motions. Then the senior party need not provide his materials to the junior party until the junior party has completed taking his testimony-in-chief.

It is obvious, therefore, that the nondiscretionary discovery under 287(a) will be of no use to the junior party in

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35. *See* Advisory Committee Notes to the 1970 Amendments to Rule 34.

36. F.R.C.P. 26(b)(3).

37. 37 C.F.R. §1.56:

"Improper applications. Any application signed or sworn in blank, or without actual inspection by the applicant, and any application altered or partly filled in after being signed or sworn to, and also any application fraudulently filed or in connection with which any fraud is practiced or attempted on the Patent Office, may be stricken from the files."

preparing his case-in-chief. Also, discovery may not be obtained under 287(c) until after the close of the motions period. Under the majority's reading of section 24, therefore, which would confine the parties to discovery through the administrative proceeding, there is no device by which a litigant may obtain discovery of evidence which is expected to become unavailable before the commencement of discovery in the Patent Office under Rule 287. Nor may a party obtain discovery earlier than 287 allows even though such accelerated discovery would materially accelerate termination of the litigation.

Fifth, Rule 287 provides only for discovery of information that is under the control of one of the parties. Thus the majority's reading of section 24 deprives litigants of the benefit of pretrial disclosure of relevant information that may be in the hands of *non-parties*.

Aside from the much narrower scope given discovery by the majority's ruling, another serious defect is apparent. In overruling *Natta*, the majority rejects the construction of section 24 which, as previously noted, has been accepted by every court of appeals that has considered the question. Therefore the extent of discovery available to Patent Office litigants will hereafter depend upon the fortuity of the location of the evidence sought to be discovered, since only within the Third Circuit will discovery be confined to the limited discovery available administratively. This lack of homogeneity among the courts of appeal may result in serious injustice where disclosure of one party's evidence is controlled by the law of this Circuit, while divulgence of that of the adversary party is governed by the decisions of another Circuit.

V.

Therefore, on the basis of the considerations set forth above and the statutory interpretation explicated by Judge Van Dusen, I would adhere to the interpretation of section 24 propounded in *Natta*. There remains, therefore, only

the application of that construction of the statute to the facts of these cases.

I concur in Judge Van Dusen's discussion of the proper resolution of Frilette v. Kimberlin. In view of the majority's holding today, an extensive discussion of how I would resolve *Duffy* under this Court's previous decision in *Natta* would serve no useful purpose. Suffice it to say therefore, that I find no abuse of discretion [38] by the district court in allowing Duffy to proceed with discovery related to whether Barnes and Preziosi filed their patent application fraudulently.[39]

Judge Van Dusen concurs in this opinion.

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38. In Montecatini Edison v. E. I. duPont de Nemours & Co., 434 F.2d 70, 72 (3d Cir. 1970), this Court ruled that on review of discovery orders under section 24, the district court's actions should be tested against the standard of abuse of discretion.

39. Three factors provide a basis for the district court's decision permitting discovery limited to the issue of fraud in the filing of the application. First, there is serious question whether the materials in question may be obtained through discovery in the Patent Office, because of the strictures imposed on such discovery by Rule 287. Second, the requested discovery, if available in the Patent Office at any time, could not have been obtained under Rule 287 at the time Judge Coolahan permitted such discovery in the district court, since the discovery period in the Patent Office had not commenced. Third, it was possible that such earlier discovery would have led to a measureable advance of the litigation and, conceivably, to its prompt termination.

Two other considerations indicate that in some circumstances the refusal of discovery by the district court might well be warranted first, the inconvenience occasioned by the possibility of discovery conducted simultaneously before two tribunals, and second, the potentially disruptive impact of such proceedings on the methods adopted by the Patent Office for disposition of controversies before it. However, the district court's conclusion that, in this case, the factors favoring a grant of discovery outweigh those suggesting the contrary result is not, in my judgment, so clearly improper as to constitute an abuse of discretion.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit.

(A.O.—U. S. Courts, International Printing Co., Phila., Pa.)

IN THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 73-1635 and 73-1695

RICHARD J. DUFFY,

Plaintiff-Appellee

v.

GERALD BARNES, JOSEPH R. PREZIOSI, WILLIAM F. McGUINNESS, JAMES B. DUKE, RICHARD A. CRAIG, CHARLES C. FARONI, RICHARD C. BAUBLES and DONALD SAGER,

Defendants-Appellants.

(D.C. No. 822-73)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

Present: SEITZ, Chief Judge and VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, Circuit Judges

JUDGMENT ON REHEARING

This cause came on to be heard on the record from the United States District Court for the District of New Jersey and was reargued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District

Court, filed July 24, 1973, be, and the same is hereby reversed. Costs taxed against appellees.

ATTEST:

/s/ Thomas F. Quinn
Clerk

December 16, 1974

A-54

IN THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 73-1635 and 73-1695

RICHARD J. DUFFY,

Plaintiff-Appellee

v.

GERALD BARNES, JOSEPH R. PREZIOSI,
WILLIAM F. McGUINNESS, JAMES B. DUKE,
RICHARD A. CRAIG, CHARLES C. FARONI,
RICHARD C. BAUBLES and DONALD SAGER,

Defendants-Appellants.

(D.C. No. 822-73)

Before: SEITZ, Chief Judge, VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, Circuit Judges.

ORDER

Upon consideration of Plaintiff-Appellee's Motion to Correct and to Amend Judgment and Memorandum of Opinion,

It is ORDERED that the motion is granted in part and denied in part as per the attached Order amending the opinion and judgment.

BY THE COURT,

/s/Joseph F. Weis, Jr.
Circuit Judge

DATED: January 27, 1975

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 73-1622

VINCENT J. FRILETTE, and PAUL R. WEISZ,
Movants

CHARLES N. KIMBERLIN, JR. and
ELROY M. GLADROW,
Opposers

VINCENT J. FRILETTE and
PAUL R. WEISZ,
Appellants

• • •

Nos. 73-1635 and 73-1695

RICHARD J. DUFFY,
Plaintiff-Appellee

v.

GERALD BARNES, JOSEPH R. PREZIOSI, et al.,
Defendants-Appellants

Before: SEITZ, *Chief Judge,* VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, *Circuit Judges.*

ORDER

It is ORDERED that the slip opinion heretofore filed is amended as follows:

The first three sentences in the third full paragraph on page 4 are amended to read as follows:

In the preliminary stages of the *Duffy* case, the junior party, Barnes, et al., filed a motion[1] supported by affidavits. The motion was denied by the patent examiner, and in due course the junior party sought relief from the Commissioner of Patents. In the interim, the senior party, Duffy, applied to the district court in New Jersey . . .

Footnote 1 shall read:

The motion sought to amend the original application for the patent, which had listed Barnes and Preziosi as co-inventors, by deleting the name of Barnes. The purpose of the motion was to make the application for the patent consistent with the preliminary statement of the junior party which had shown Preziosi as the sole inventor.

Footnote 1 at the bottom of page 4 will be renumbered to be footnote 1a and is amended to read as follows:

The court's order was handed down on July 24, 1973, and an appeal was promptly filed in this court at No. 73-1635. A request for stay was filed on July 25, 1973 and denied on July 30, 1973. A second appeal was filed from the district court's order of August 6, 1973 at No. 73-1695 together with a motion for stay and for clarification which was denied on August 22, 1973. Yet a third motion was filed in this court on October 12, 1973, seeking impoundment of or prohibition against the use of evidence obtained by discovery. After argument, the motion was denied. Cross motions by Duffy for attorneys' fees and dismissal of the appeals were referred to the panel to which the appeals were to be assigned.

The last paragraph of the majority opinion on page 13, beginning with "The order in . . ." is deleted, and the following paragraphs substituted therefor:

The request by the junior party, Barnes, to impound or enjoin the use of the evidence obtained by discovery will be denied. At this stage, it is not practicable to attempt to unscramble the eggs. The question of whether the evidence is admissible in proceedings in the Patent Office or other forums is a matter for decision by the body which might be asked to consider the material. We express no views on admissibility.

The motions for attorneys' fees and for dismissal of the appeals by the senior party, Duffy, will be denied.

The order of the district court in *Frilette v. Kimberlin* will be affirmed.

In *Duffy v. Barnes*, the orders of the district court of July 24, 1973 at No. 73-1635 and of August 6, 1973 at No. 73-1695 will be reversed, each party to bear his own costs.

By THE COURT,

JOSEPH P. WEIS, JR.
Circuit Judge

DATED: January 27, 1975

IN THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 73-1635 and 73-1695

RICHARD J. DUFFY

vs.

GERALD BARNES and
JOSEPH R. PREZIOSI

Gerald Barnes and Joseph R. Preziosi, defendants, and William F. McGuinness, James B. Duke, Richard Craig, Charles C. Faroni, Richard C. Baubles and Donald Sager,

Appellants

(D. C. Civil Action No. 822-73)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

Present: SEITZ, Chief Judge and VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, Circuit Judges

AMENDED JUDGMENT ON REHEARING

This cause came on to be heard on the record from the United States District Court for the District of New Jersey and was reargued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the orders of the said District Court, dated July 24, 1973 at our No. 73-1635 and dated August 6, 1973, at our No. 73-1695,

be, and the same are hereby reversed, with each party to bear his own costs, in accordance with the amended opinion of this Court.

ATTEST:

/s/ Thomas F. Quinn
Clerk

January 27, 1975

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APR 28 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1200

RICHARD J. DUFFY,

Petitioner,

v.

GERALD BARNES, *et al.*,

Respondents.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

HARRY C. JONES, III
Counsel for Respondents
330 Madison Avenue
New York, New York 10017

Of Counsel:

JAMES G. FOLEY
PENNIE & EDMONDS
330 Madison Avenue
New York, New York 10017

RICHARD A. CRAIG
AMERACE CORPORATION
245 Park Avenue
New York, New York 10017

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1200

RICHARD J. DUFFY, *Petitioner,*

v.

GERALD BARNES, *et al.*, *Respondents.*

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Opinions Below

The opinions below appear at pages A-1 through A-59 of the Appendix to the Petition.

Jurisdiction

The jurisdictional requisites are adequately set forth in the Petition.

Questions Presented

The statement of questions presented by the Petition hardly reflects the single possible issue that could be presented by the decision of the Third Circuit Court. That issue is:

Whether the ancillary jurisdiction (35 U.S.C. § 24) conferred by Congress upon the district courts is limited in patent interference cases to the issuance of subpoenas as permitted by prior practice and as held by the court below or whether 35 U.S.C. § 24 grants broad discovery authorization to the district courts in such patent cases.

Statutory Provision Involved

The statutory provision involved is 35 U.S.C. § 24 and is set forth at page 4 of the Petition.

Statement of the Case

The facts as set out in the Petition are basically correct. However, it is to be noted that discovery was initiated in the district court by subpoenas *duces tecum,* motions to take depositions, and by requests for inspection and production of documents and things.

Reasons Why the Petition Should be Denied

The decision of the Court of Appeals for the Third Circuit involves the scope of discovery in a patent interference proceeding. There are no special and important reasons why it should be reviewed by this court. It is not in conflict with the decisions of any other Court of Appeals. To the contrary, the decision of the court below has been followed by the first Court of Appeals to subsequently consider the issue. See *Sheehan* v. *Doyle et al.* (1st Cir. March 31, 1975), set forth as an Addendum hereto at page A-1. Further, the decision sought to be reviewed concludes no case on the merits; nor does it touch the public interest. Moreover, the decision is correct in concluding that the scope of discovery under 35 U.S.C. § 24 does not permit the broad base discovery accorded by the Federal Rules of Civil Procedure.

Contrary to the assertions made by Petitioner, the decision below does not in any way constitute an abandonment of the statutory ancillary jurisdiction conferred upon the district courts; nor does it violate the doctrine of *stare decises.*

I.

The Decision Below Does Not Conflict With The Decisions Of Any Other Court Of Appeals.

The basic ground asserted by Petitioner for granting its Petition is that the Court of Appeals below, in reversing its earlier holding in *In Re Natta,* 388 F.2d 215 (3d Cir. 1968), placed itself in direct conflict with every other court of appeals that has considered 35 U.S.C. § 24 and the question of discovery jurisdiction of the district courts in patent interference cases. In support of this assertion, Petitioner quotes from the dissent of Judge Adams in the decision below (page 8 of the Petition). Judge Adams, in turn, mentions decisions of the Court of Appeals for the Second, Fifth, Seventh and Tenth Circuits as having interpreted the intent of Congress, as expressed in 35 U.S.C. § 24, in conformance with the overruled decision in *Natta.* Two of these decisions *Gladrow* v. *Weisz,* 354 F.2d 464 (5th Cir. 1965) and *Natta* v. *Zletz,* 379 F.2d 615 (7th Cir. 1967) preceded *Natta* and two, *Natta* v. *Hogan,* 392 F.2d 686 (10th Cir. 1968) and *Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.,* 314 F.Supp. 235 (D. Conn. 1968), *aff'd per curiam,* 430 F.2d 1177 (2d Cir. 1968), were rendered subsequent to *Natta.*

An analysis of each Court of Appeals decision, however, clearly shows that there is, in fact, no conflict with the decision below overruling *Natta* and that none of these cases ever raised the same issue as involved in the decision below or in *Natta.*

***In Re Natta*, 388 F.2d 215 (3d Cir. 1968).**

The precise issue involved in both the decision below and in *Natta* is the same as the question presented for this Court's review.

In *Natta*, the discovery ordered in the district court under 35 U.S.C. § 24 was argued to be in error on the grounds that it was improper to apply the "scope of discovery standards contained in the Federal Rules of Civil Procedure rather than the admissibility standards governing interference proceedings found in the Patent Office rules" (388 F.2d at 217). As a basis for this argument, the history of 35 U.S.C. § 24 was analyzed and it was contended that by the language of 35 U.S.C. § 24, Congress intended district court discovery in patent interference cases to be limited to the issuance and enforcement of subpoenas in preparing evidence for use in the interference, the practice which had prevailed prior to 35 U.S.C. § 24. Specifically, it was urged that discovery permitted by Rule 45(b) of the Federal Rules of Civil Procedure was all that was intended and not broad scope discovery as available generally under the Rules and as could be obtained under Rule 34, the rule used in seeking discovery in *Natta* and under which inadmissibility in the interference was not a ground for objection. The Court of Appeals for the Third Circuit in responding to this specific issue decided in *Natta* that:

> "This statute manifests a clear congressional intent to make available to parties to patent interferences the broad discovery provisions of the Federal Rules of Civil Procedure." (388 F.2d at 217)
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> • • •
>
> "[The] argument that the rules governing the admissibility of evidence in Patent Office interference proceedings control and, therefore, the discovery standards of the Federal Rules of Civil Procedure should not have been applied below cannot be accepted. The fact that evidence obtained . . . as a result of

the District Court's order may not be admissible in the proceedings pending before the Patent Office does not vitiate [the party's] right to obtain it." (388 F.2d at 219)

***Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965).**

In *Gladrow*, the parties to the interference in the Patent and Trademark Office* were at the stage where cross-examination of the senior party was being taken and the junior party was attempting to obtain specific documents. For this purpose, the junior party moved in the district court under 35 U.S.C. § 24 and Rule 34 of the Federal Rules of Civil Procedure. The court in responding to the argument that Section 24 made no important change in the procedure authorized by the previous practice under Section 54 stated:

> "That much may be conceded arguendo. . . . The present order does not extend beyond that authorization." (354 F.2d at 467-8)

Also, in responding to the argument that the use of Rule 34 of the Federal Rules of Civil Procedure was improper and that discovery should have been sought by subpoena under Rule 45, the court stated:

> "It would be making a fetish of formalistic procedure to reverse the present judgment [permitting discovery under Rule 34] but hold that production of the documents could be required under a subpoena duces tecum [Rule 45]." (354 F.2d at 468)

Thus, it is clear that the discovery sought in *Gladrow*, although under Rule 34, was no broader in scope than could have been obtained under Rule 45 and as permitted by the decision of the court below.

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* Hereinafter called the Patent Office.

***Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967).**

In this case, the Patent Office interference had reached the rebuttal stage at the time discovery was sought in the district court. The documents desired were for use in the examination on rebuttal. The district court denied the request for discovery and the only issue on appeal to the Seventh Circuit was whether or not the discovery could be obtained without the Patent Office having first specifically set a special testimony period in which to receive the evidence sought to be obtained in the district court. There was no issue as to the scope of discovery permitted under 35 U.S.C. § 24 and the case is certainly not contrary to or in conflict with the specific holding of the Court of Appeals for the Third Circuit in the decision below.

The absence of any conflict in the *Gladrow* and *Zletz* cases is recognized in the decision below where Judge Weis, speaking for the majority, stated:

> "The earlier cases of *Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965),[4] *Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967),[5] and *Korman* v. *Shull*, 184 F.Supp. 928 (W.D. Mich. 1960),[6] all involved instances where testimony was being prepared and subpoenas either had or could have been issued to compel production of documents. None of those cases actually involved pretrial discovery as that term is understood in the usual civil litigation." (A-21-22 of Petitioner's Appendix with footnotes omitted)

Further, Judge Seitz in the dissent in *Natta*, after analyzing these same cases, stated:

> "I think, contrary to the majority, that even the language quoted by the majority from Gladrow v. Weisz, 354 F. 2d 464 (5th Cir. 1965) shows that the court was talking about the use of the Federal Rules solely in connection with production for use in making the record for the Interference proceedings. The court

said that Rule 34 could be used to obtain documents required for examination or cross-examination of a witness. I agree. But this is not to say that such production is not to be tested by evidentiary standards. In my view the Gladrow case reached the result which I think is dictated here. I do not read Natta v. Zletz, 379 F.2d 615 (7th Cir. 1967) to the contrary. Indeed, had the district court determined here that the production was to be measured by evidentiary rather than discovery standards I would have no quarrel with its interpretation of the statute." (388 F.2d at 223)

Subsequent to *Natta* and prior to the decision below, both the Court of Appeals for the Tenth Circuit (March of 1968) and the Court of Appeals for the Second Circuit (November of 1968) were involved in discovery cases where discovery was sought under 35 U.S.C. § 24. As with the Court of Appeals cases preceding *Natta*, however, the issues raised on appeal were not the same as involved in *Natta*.

***Natta* v. *Hogan*, 392 F.2d 686 (10th Cir. 1968).**

In this case, discovery was again sought under Rule 34 of the Federal Rules of Civil Procedure. Discovery was objected to on the grounds that it should have been sought under Rule 45. It was argued that 35 U.S.C. § 24 "contemplates initiation of discovery proceedings only by the issuance of a subpoena" (392 F.2d at 690). The court in declining to accept this argument stated:

"The contention that jurisdiction is not obtained until a subpoena is issued and that only then may a Rule 34 motion be presented *glorifies form over substance. Such formalistic procedure performs no useful purpose.*[6] We see no reason for the issuance of a subpoena to an unneeded witness when the desired documents

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"[6] See *Gladrow* v. *Weisz*, 5 Cir. 354 F.2d 464, 468, and *Hickman* v. *Taylor*, 329 U.S. 495, 505-506, 67 S.Ct. 385, 91 L.Ed. 451."

> 24 gives to parties in Patent Office proceedings the may be obtainable through the use of Rule 34. Section right to secure documents in accordance with the provisions of the federal civil rules. The power of the federal courts to enforce that right is not dependent on any particular formalism of procedure." (Emphasis added) (392 F.2d at 690)

• • •

Thus, on its facts, *Hogan* was limited to discovery commensurate with that permitted by the Court of Appeals for the Third Circuit in the holding below. Certainly, there is no holding in *Hogan* which is in direct conflict with the decision below.

***Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.*, 314 F.Supp. 235 (D. Conn. 1968), *aff'd per curiam*, 430 F.2d 1177 (2d Cir. 1968).**

Here, the Court of Appeals for the Second Circuit *affirmed per curiam* the decision of the District Court of Connecticut permitting the taking of discovery under 35 U.S.C. § 24 by means of subpoena *duces tecum* and by motion for the production of documents under Rule 34 of the Federal Rules of Civil Procedure. Although Section 24 and Rule 34 were involved, the district court was presented with the sole question as to *when* discovery may be taken and not any issue as to the substantive scope of discovery. The parties in the Patent Office interference had commenced the taking of testimony and discovery in the district court was sought by the junior party. In objecting to this discovery, the senior party asked the court:

> ". . . to foreclose discovery until after the junior party completes its initial presentation because to do otherwise would 'strip the senior party of the procedural advantages accorded him by virtue of his earlier filing date.' " (314 F.Supp. at 237)

In declining to accept this argument the district court concluded:

> "Moreover, the broad mandate of the statute manifests an explicit congressional intent to allow both parties to a patent interference to apply for discovery at any time during the contested proceeding." (214 F.Supp. at 237)

In this case, the only interpretation of the intent of Congress, as expressed by 35 U.S.C. § 24, made by the district court was in regard to the single issue of the timing of discovery. Since this is not the holding of the Court of Appeals of the Third Circuit in the decision below, there is no conflict with that holding.

Sheehan v. _Doyle_, 1st Cir. March 31, 1975 Addendum hereto at A 1.

The only other Court of Appeals which has specifically considered this same question as involved in the decision below is the Court of Appeals for the First Circuit in the *Sheehan* case. In this case, the court not only considered precisely the same issue but adopted the arguments and analysis respecting 35 U.S.C. § 24 as made both by Judge Seitz in the dissent in the *Natta* case and as set forth in the decision below overruling *Natta*. Further, the Court of Appeals for the First Circuit makes it clear that the controlling factor is not what particular rule is used (Rule 45(b) or Rule 34) but how such rule is applied in obtaining discovery.

> ". . . section 24 does not confer jurisdiction upon the district court, *acting on its own,* to grant Rule 34 discovery *directly,* . . ." (Emphasis added) (A 5 of the Addendum hereto)

* * *

> *"Our decision does not have the effect of precluding broad-based Federal Rules discovery in patent inter-*

> *ferences to the extent permitted by the Commissioner,* whose rules presently allow such discovery 'if justice so requires' . . . . Judicial subpoenas that may appropriately aid in any such authorized discovery, as well as to obtain testimony and evidence for use in the proceeding in progress, remain available. *Our decision merely precludes use of federal courts as alternative forums of first resort rather than as forums acting strictly in aid of the primary proceeding."* (Emphasis added) (A 7 of the Addendum hereto)

Under Rule 19 of the Rules of the Supreme Court, review of a Court of Appeals decision on writ of certiorari may be had where the Court of Appeals decision is in conflict with the decision of another Court of Appeals on the same matter. However, as stated in the *Address by The Honorable John M. Harlan on October 28, 1958,* 13 Record of N.Y.C.B.A. 541 (1958):

> "Moreover, differences between the Courts of Appeals in two or more circuits will not be accepted as a conflict if they can fairly be accounted for on the basis of variations in the factual situations among the cases involved." (13 Record of N.Y.C.B.A. at 552)

From the analysis of the decisions of the Courts of Appeals involving 35 U.S.C. § 24, it is evident that the decision below creates no such direct conflict requiring or suggesting the desirability of review by this Court.

II.

The Decision Below Is Not Conclusive On The Merits; Nor Does It Touch The Public Interest.

Apart from the fact that the decision of the Third Circuit below is not in conflict with the decision of any other Court of Appeals and therefore does not meet one of the standards used to determine whether this Court should grant

certiorari (Rule 19 of the Rules of the Supreme Court), there are no other special and important reasons why the decision should be reviewed by this Court.

To put the subject matter in perspective, it must be said that the problem involves only discovery or one of the steps on the path to resolution of the whole controversy. No controversy was decided on the merits by the decision below. No rights and privileges were fixed. No one can say, assuming that certiorari is granted, how many more matters will be pursued under Section 24 before the main controversy is in condition for decision.

Furthermore, what has been decided by the Third Circuit below and is sought to be reviewed by this Court is not a matter involving the great public interest whatsoever. An interference is a special Patent Office procedure designed solely for purposes of determining who, among a number of applicants, is the first inventor. In this context, the case below involved only a matter of discovery procedures.

III.

The Decision Of The Court Of Appeals *En Banc* Properly Limited The Scope Of Discovery Authorized By The District Court Pursuant To 35 U.S.C. § 24.

In concluding that production under 35 U.S.C. § 24 must be measured by evidentiary rather than discovery standards, the Court of Appeals for the Third Circuit (seven out of nine Judges thereof) was influenced by certain important factors that always existed as well as those that followed from the *Natta* decision. These factors are the following:

1. The main forum for an interference proceeding is the Patent Office. An interference is a proceeding authorized by 35 U.S.C. § 135 solely to determine which of two or more applicants is entitled to a patent.

2. The trial record in an interference proceeding consists of testimony taken pursuant to the Rules of Practice of the Patent Office by way of deposition, affidavits, and stipulations, as well as documents and other exhibits relevant to the issue of priority of invention.

3. Interference proceedings are conducted pursuant to a regimen and timetable fixed by the Patent Office to bring the priority evidence into focus.

4. This regimen and timetable allocates specific periods when the parties are permitted to elicit direct evidence, rebuttal evidence, and impeaching evidence.

5. In 1968, the Third Circuit handed down the *Natta* decision which contained the gratuitous statement that Section 24 manifested a congressional intent to make the broad discovery provisions of the Federal Rules of Civil Procedure applicable to patent interferences (388 F.2d at 217).

6. As a consequence of the *Natta* decision, applications in the district courts for production pursuant to Section 24 were made independently of the limited procedures fixed by the Patent Office in interference cases. This imposed a burden on the district courts to deal with a limited phase of a proceeding over which it had no general control.

7. Consequently, the function of the district courts changed from one ancillary to the Patent Office proceedings to that of the forum actually controlling the progress of the interference.

8. As a further consequence, proceedings in the Patent Office had to be stayed while discovery in the district courts ran its course without reference to the trial procedure set by the Patent Office.

9. Matters of discovery which are interlocutory in nature in normal civil litigation were final in the district court

and, therefore, appealable. The courts of appeals then became involved in the same limited phase of the interference which had been brought to the district court.

10. Despite the scope of discovery permitted by the district courts under Section 24 proceedings, certain of the discovered subject matter was not received by the Patent Office, it being determined to be non-evidentiary on the issues in the interference.

11. As a consequence of the uncertainty growing out of the *Natta* decision, the Patent Office promulgated its own rules for discovery in interference cases in 1971 (see Patent Office Rule 287, 37 CFR § 1.287 promulgated under the authority of 35 U.S.C. §§ 6 and 23).

12. Broad discovery is not foreclosed forever from a party to a patent interference. 35 U.S.C. § 146, for example, provides for an appeal to the district court from a ruling of the Patent Office and such proceeding carries with it the full scope of discovery accorded by the Federal Rules.

13. A historical reanalysis of 35 U.S.C. § 24 confirms the conclusion reached by Judge Seitz in his *Natta* dissent; i.e., that Section 24 does not include the authority to use the Federal Rules of Civil Procedure to obtain the production of documents which are not admissible in evidence or needed to examine witnesses.

These factors as well as previous authorities on the subject were fully evaluated by the Third Circuit in reaching its conclusion. There is no way that respondents can improve on the Third Circuit's effort. Respondents rely on it and its propriety as a reason why the intervention of this Court is unnecessary. We also rely on Judge Seitz's dissenting opinion in the *Natta* decision (388 F.2d beginning at 221).

We have mentioned above in this brief that the Court of Appeals for the First Circuit has, since the filing of the Petition here, handed down a decision following the decision below. *Sheehan* v. *Doyle, supra.* We add the *Sheehan* decision as confirmation of the lack of need for intervention by this Court.

IV.

The Decision Of The Court Below Does Not Constitute An Abandonment Of Jurisdiction Under 35 U.S.C. § 24.

This argument of the Petitioner that the Third Circuit abandoned jurisdiction depends upon the assumption that jurisdiction under Section 24 is properly exercised only by according broad discovery in interferences. The court below took this argument into consideration and disposed of it as follows:

> "The question is, did Congress in fact grant the jurisdiction which *Natta* thought to exist or did that conclusion come about only by erroneous construction and interpretation [of Section 24]. We conclude that the latter is true." (Appendix to Petition at A-26.)

The court did not abandon jurisdiction. It exercised it. But it properly limited that jurisdiction to the subject matter that is conferred by Section 24.

V.

The Decision Of The Court Below Does Not Violate The Rule Of *Stare Decisis.*

In considering the precedent of *Natta,* the Court below said the following:

> "We do not lightly overturn precedent, and *stare decisis* must be treated with respect. But when on

> deep and mature reconsideration it becomes apparent that an error has been made by the court, the proper step is correction. This is particularly so in a matter of procedure where no substantive rights are vested as a result of the earlier decision." (Appendix to Petition at A-26, A-27)

Judge Adams himself, contrary to his expressions in support of *stare decisis* in his dissent below, has noted occasions when precedent gives way. As he said in *In Re Central Railroad Company of New Jersey,* 485 F.2d 208 (3d Cir. 1973), *cert. den.,* 414 U.S. 1131 (1974):

> ". . . it has long been the rule in this Circuit that decisions made in similar cases by panels of this Court are binding on other panels but are not controlling on the Court En Banc. Indeed, it is *only* through the Court En Banc that precedents established by earlier panel decisions may be reexamined." (Footnotes omitted) (485 F.2d at 210-11)

The Supreme Court finds from time to time that precedent must give way to reason as witness some recent examples in patent related matters such as *Lear Inc.* v. *Adkins,* 395 U.S. 653 (1969) and *Blonder-Tongue* v. *University Foundation,* 402 U.S. 313 (1971).

Surely the rule of *stare decisis* does not require the court sitting *en banc* to adhere to the precedent it believes was erroneously set by a panel of the court. This should be particularly true when the precedent and its reversal do not conclude any controversy on the merits.

CONCLUSION

For all of the above reasons, the petition for writ of certiorari should be denied.

Respectfully submitted,

HARRY C. JONES, III
Counsel for Respondents

Of Counsel:

James G. Foley

PENNIE & EDMONDS
330 Madison Avenue
New York, New York 10017

Richard A. Craig

AMERACE CORPORATION
245 Park Avenue
New York, New York 10017

Addendum

Addendum A—Opinion, Sheehan v. Doyle.

United States Court of Appeals

FOR THE FIRST CIRCUIT

No. 74—1318

JOHN C. SHEEHAN,

Plaintiff-Appellee,

v.

FRANK P. DOYLE, et al.,

Defendants-Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

Before COFFIN, *Chief Judge,*
McENTEE and CAMPBELL, *Circuit Judges.*

ALBERT L. JACOBS, JR., with whom JACOBS & JACOBS, P.C., OWEN F. CLARKE, JR., and SULLIVAN & WORCESTER were on brief, for appellants.

THOMAS E. SPATH, with whom N. DALE SAYRE, McLEAN, BOUSTEAD & SAYRE, ROBERT J. HORN, JR., KENWAY and JENNEY were on brief, for appellee.

March 31, 1975

CAMPBELL, *Circuit Judge.* This appeal concerns the authority of the district court for the District of Massa-

chusetts to order discovery in aid of a patent interference proceeding being conducted before the Board of Patent Interferences in Arlington, Virginia.

Doyle (a name used for three nonresident aliens) is engaged in an interference in the United States Patent Office against Sheehan, a Massachusetts resident. *See* 35 U.S.C. § 135. At issue is whether Doyle or Sheehan is the first inventor of processes for the production of penicillin. Doyle has applied for a United States patent, Sheehan already having been granted one covering the same subject matter.

One might suppose that the scope of discovery for use in an interference[1] would be determined by the Patent Office

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[1] An interference—an administrative proceeding in the Patent Office—follows a distinct format. After parties have preliminarily stated their positions, 37 C.F.R. §§ 1.215-1.223, and the period for filing motions has been set, *id.* §§ 1.231-1.244, the Board of Patent Interferences establishes a schedule for the parties' presentation of evidence by means of deposition, affidavit, or stipulation, *id.* § 1.251. The patent applicant who was later in time (the "junior party") is required to produce his evidence first and carries the burden of disproving the order of application. *Id.* § 1.257. Testimony is to be taken before an officer authorized to administer oaths, *id.* § 1.274, and must always be filed in the Patent Office, *id.* § 1.278. If objections are made to the witness or evidence, the evidence shall be taken away and the objection noted by the officer. *Id.* § 1.275 (d). In determining whether to receive or exclude evidence, the Patent Office will "strictly" apply "the established rules of evidence". *Id.* § 1.286.

The discovery provision for interferences, Rule 287, only requires a party to furnish his opponent with lists of things, names of witnesses, and copies of documents "upon which the party intends to rely". *Id.* § 1.287(a). The senior party—Sheehan in this case—need not provide such materials to the junior party until the junior party has completed taking his testimony. There is no discovery of right of matters which might build an affirmative case for the discovering party or which might undercut the opponent's case-in-chief. However, the Board may grant further discovery privileges, within the scope of the Federal Rules of Civil Procedure, at any time during the proceedings "upon a showing that the interest of justice so requires". *Id.* §1.287(c).

or at least coordinated with the administrative proceeding within its jurisdiction; and Congress has in fact conferred statutory authority upon the Commissioner of Patents to "establish rules for taking affidavits and depositions required in cases in the Patent Office", 35 U.S.C. § 23, and the Commissioner has adopted certain rules, *see* note 1 *supra.* But in section 24, Congress has also conferred certain powers upon district courts. Historically section 24 developed to provide for the issuance of subpoenas to compel testimony and evidence required in Patent Office interferences; but a sentence in section 24 inserted by Congress in 1952 has been construed by a number of courts also to allow parties to an interference to obtain at any time broad-based discovery in district courts in separate, self-contained proceedings.[2] *See infra.* Such dis-

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[2] Section 24, 35 U.S.C. § 24, provides in its entirety, "Subpoenas, witnesses".

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena." [Emphasis supplied.]

covery goes on outside the ambit of the Patent Office proceeding and beyond the scope permitted without special approval under its rules.

Citing section 24 and bypassing the Patent Office's procedures, Doyle brought an independent action in the district court for the District of Massachusetts to obtain discovery from Sheehan under the Federal Rules of Civil Procedure. The court issued a subpoena duces tecum against Sheehan and, after hearing Sheehan's objections, refused to quash the subpoena and directed Sheehan to produce the requested records and appear to be deposed. In addition to the discovery of Sheehan, Doyle's counsel was able to obtain from the court subpoenae duces tecum against two organizations, also located in Massachusetts, having an interest in the Sheehan patent. Doyle's goal in these ancillary proceedings has been to discover evidence that an abandoned Sheehan patent application in 1957, while disclosing some processes, did not disclose enough to enable Sheehan to claim first invention to the processes for which Sheehan obtained the disputed patent in 1959 and as to which Doyle has a claim to invention dating from late 1957.

While Doyle's discovery was in progress, Sheehan, also invoking section 24, filed a request under Rule 34, Fed. R. Civ. P.,[3] for the production of documents from Doyle and

[3] Rule 34(a), Fed. R. Civ. P., provides in pertinent part:

"Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on his behalf, to inspect and copy, any designated documents . . . or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served. . . ."

Rule 26(b) generally allows a party to obtain discovery of "any matter, not privileged, which is relevant to the subject matter involved in the pending action". Rule 26(b) further provides, "It is not ground for objection that the information sought will be inadmissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence."

his assignee, Beecham Research Laboratories, Inc. (BRL), a British corporation and the real party in interest. Sheehan sought documents of tests and evaluations, made by BRL and to be introduced in interference testimony, concerning the sufficiency of the Sheehan disclosure in its abandoned 1957 application. After considering arguments for and against compelling discovery from the nonresident aliens, the district court ordered Doyle and BRL to produce those documents sought that were not privileged. From this order Doyle now appeals. Doyle objects to the order on grounds of lack of personal jurisdiction and of proper venue, as he is a nonresident alien with no ties to Massachusetts. We do not reach these arguments because we hold that section 24 does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a nonresident alien or a resident citizen.

A threshold question is the appealability of the district court's discovery order. A discovery order is not usually "final"—and hence not immediately appealable—as the litigation in conjunction with which the discovery is sought is still pending in the district court. 28 U.S.C. § 1291. Discovery here, however, is ancillary to the interference in Arlington, Virginia, at the Patent Office, and nothing else was pending at the time in the Massachusetts court. The instant order, therefore, concluded—at least for the moment—the business of the district court. Thus, while the usual policy against piecemeal appellate review dictates otherwise, we must regard the order as final and appealable. *See Natta* v. *Hogan,* 392 F.2d 686, 689 (10th Cir. 1968). (Indeed, Doyle has sought more discovery since this appeal was heard, and the district court's next ruling would likewise be final and appealable.)

The next issue is whether section 24 authorizes the Rule 34 discovery Sheehan seeks. When this appeal was argued,

it was accepted among the circuits that had passed on the matter that section 24 authorized discovery beyond that permitted by the Patent Office, and in particular the production of documents from a party by means of a Rule 34 motion. *See, e.g., Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.*, 430 F.2d 1177 (2d Cir. 1968), *aff'g mem.* 314 F. Supp. 235 (D. Conn. 1968); *In re Natta*, 388 F.2d 215 (3d Cir. 1968); *Natta* v. *Hogan*, 392 F.2d 686 (10th Cir. 1968); *Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967); *Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965). However, subsequent to argument the Third Circuit ruled, *en banc*, that section 24 merely confers upon district courts jurisdiction to issue, in aid of the interference, subpoenas as provided in Fed. R. Civ. P. 45(a), (b), (c), (d) (2) & (3), and (f).[4] *Frilette* v. *Kimberlin*, 508 F.2d 205 (3d Cir. 1975) (*en banc*). The practical effect of this ruling is to permit the compelling of testimony and evidence by the district court which is sought at the proper stage of the Patent Office proceeding, and also to allow the issuance of subpoenas in aid of discovery as authorized by the Patent Office but not otherwise. *See* note 1 *supra.*

The Third Circuit's decision was a reversal of its position in *In re Natta, supra*, and a vindication of Judge (now Chief Judge) Seitz's dissenting opinion in the earlier case. 388 F.2d at 221-23. Unlike that circuit, this circuit has never previously passed on the matters.

We believe that the broad reading which courts have given section 24 over recent years goes beyond what Congress could reasonably have had in mind. The unfortunate effect is to generate self-contained discovery proceedings out of joint with the administrative proceeding to which,

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[4] Rule 45(d)(1), Fed. R. Civ. P., authorizes the compelling of discovery within the scope of Rule 26(b), *see* note 3 *supra*, and therefore is inconsistent with the existing Patent Office discovery rules for interferences.

ostensibly, they are linked. The arguments and analysis, which we adopt and need not repeat, are well set forth in Judge Seitz's dissent in *In re Natta* and in *Frilette.* We agree that section 24 is simply a provision giving teeth, through the courts' subpoena powers, to authority conferred upon the Commissioner of Patents. Such a reading is consistent with the fact that section 23 confers general authority upon the Commissioner of Patents to promulgate rules with respect to depositions and affidavits; with the tenor of section 24; and with the absence of evidence that any sweeping substantive change was intended in the 1952 redraft of section 24 which introduced the sentence in question. If Congress had intended to erect a free wheeling discovery vehicle totally outside the control of the Patent Office, one would have expected some inkling in the legislative history.

Our decision does not have the effect of precluding broad-based Federal Rules discovery in patent interferences to the extent permitted by the Commissioner, whose rules presently allow such discovery "if justice so requires". *See* note 1 *supra.* Judicial subpoenas that may appropriately aid in any such authorized discovery, as well as to obtain testimony and evidence for use in the proceeding in progress, remain available. Our decision merely precludes use of federal courts as alternative forums of first resort rather than as forums acting strictly in aid of the primary proceeding.

Sheehan contends that the effect of a decision following the Third Circuit would be to insulate nonresident aliens from ancillary discovery, since a subpoena cannot be served upon them. But ancillary judicial discovery is unnecessary as to parties, since the Commissioner has the power to compel testimony or evidence by the threat of dismissing the application. *See* 37 C.F.R. § 1.259. The Patent Office has no power to compel the attendance of nonparty witnesses or to enforce the production of evidence from them, and this

need was apparently the main reason that Congress conferred ancillary jurisdiction upon federal courts, with their subpoena power and threat of contempt.

It may nevertheless seem unfair in this case to deny Sheehan discovery against Doyle after Doyle has had the advantage of extensive discovery from Sheehan under section 24.[8] However, we are not inclined to impose our notions of fairness on the agency which has been delegated primary authority to control the interference. Moreover, evidence not taken in accordance with the Patent Office rules will not be considered in determining the interference, 37 C.F.R. § 1.271, and in any event a party aggrieved may litigate through *de novo* proceedings in the district court, 35 U.S.C. § 135.

Reversed. No costs.

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[8] Even during the junior party's testimony period, the junior party may not plunge into the senior party's direct case by issuing subpoenas to the senior party. Such a course would be contrary to the set order of taking testimony.